

IN THE
SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1917.

NEW YORK SCAFFOLDING COMPANY,

Petitioner,

VS.

CHAIN BELT COMPANY AND EGBERT WHITNEY,

Respondent.

On Petition for Writ of Certiorari.

BRIEF FOR RESPONDENT.

The petition by the plaintiff below is based on the fact that the Court of Appeals of the Seventh Circuit followed the unanimous opinion of the Court of Appeals of the Eighth Circuit, holding that the patent in suit was not infringed by the Whitney "Little Wonder" hoist, however placed; or by the "Whitney Scaffold Hoist," except when placed parallel to the wall and not attached to the cross timbers (a construction which renders it valueless). This is complained of as in conflict with the opinion of the Court of Appeals of the Third Circuit, holding the patent altogether invalid, and for that reason refusing petitioner the relief sought.

It is one of three cases under the same patent in which petitioner is seeking a writ to review the unanimous opinions

of three different Courts of Appeal, all holding that the patent in suit cannot be sustained as covering what petitioner contends—one of them holding that it represents no invention and is altogether invalid, and the other two holding that it can only be sustained if so limited as to cover nothing except what was abandoned as soon as tried, considerably before this suit was brought, and what plainly has no practical value. The distinctions relied upon to sustain the patent are trivial mechanical details of the narrowest character, and we think the Court of Appeals of the Third Circuit was right in holding the claims altogether invalid as representing no patentable invention. If that court had adopted either the first or last opinion of the Court of Appeals of the Eighth Circuit (followed in the present case by the Court of Appeals of the Seventh Circuit), it would still have been compelled to find that there was no infringement, and the result to the plaintiff must have been dismissal of the bill for want of equity.

The real controversy is over the right of plaintiff to have this Henderson patent so expanded as to subordinate defendant's "Little Wonder" machine, made under the Whitney patent No. 1,114,832, of October 27, 1914, under and in accordance with which all Whitney machines have been manufactured for more than three years past; and also to escape the limitations imposed on it in the first opinion of the Court of Appeals of the Eighth Circuit as the only means to avoid holding it invalid. The three judges of the Court of Appeals of the Eighth Circuit and the three judges of the Court of Appeals of the Seventh Circuit are agreed in finding that this "Little Wonder" machine, in whatever way used, does not infringe the patent in suit, while the three judges sitting in the Court of Appeals of the Third Circuit, the judge sitting in the District Court of that Circuit, the judge who originally heard the case in the District Court of the Eighth Circuit, and one of the judges who sat in the first hearing in the Court of Appeals of the

Eighth Circuit, have agreed in finding that the patent is utterly invalid.

There can be no pretense that the question whether the patent is to be held altogether invalid or to be saved from utter defeat by reading into it specific limitations which neither plaintiff nor defendant employs and which were never asserted or regarded as invention until it was evident that the patent was otherwise defeated, is one of general interest or presents any novel principle of law. On the contrary, it distinctly appears in the present record that plaintiff (which claims to have had substantially exclusive control of the market for such machines both before and since the invention in controversy) is, and throughout has been, abstaining from the manufacture or use of the Henderson, and manufacturing and using its hoists in accordance with the prior Murray patent, No. 854,959 (not to be confounded with the Murray patent, No. 882,806, also in evidence), which exhibits the same hoist set edgewise instead of parallel to the wall and positively fastened to the cross timbers, and that the manufacturer of defendant's machine (Whitney) abandoned the features to which each of these courts holds the patent must be limited almost immediately upon trying them, and before the earliest of these suits was begun.

The petition mentions no error of law of which it can complain. Its grievance is that the court adopted the opinion of the Eighth Circuit, finding the patent so specifically limited as not to be infringed by the "Little Wonder" machine, instead of adopting the opinion of the Third Circuit, holding the patent altogether invalid. Its criticisms of the unanimous finding on questions of fact is plainly without merit. It is sufficient that this court does not review such findings upon a petition of this kind.

The *first* assignment of error rests upon the fact that the court adopted the opinion of the Eighth Circuit, holding the patent so limited as not to be infringed, instead of that of the

Third Circuit holding it altogether invalid, which would have resulted in a dismissal of the bill at plaintiff's costs.

The *second* charges that the court "failed to apply the doctrine of equivalents." What the court held was that defendant's "Little Wonder" machine was not the equivalent, and did not contain the equivalent, of plaintiff's alleged invention. All these courts were perfectly familiar with the doctrine of equivalents and liberal in applying them where they found any semblance of invention, and the courts of appeal of both the Seventh and Eighth Circuits were unanimous in finding that nothing that can be imputed to plaintiff's patent as the subject of invention was present in defendant's "Little Wonder" machine.

Just what is meant by the *third* assignment of error is not clear, but it plainly does not specify any error of law involved in the decision complained of.

The *fourth* assignment relates to a finding of fact upon which the court was unanimous. The court below had overlooked the fact that the direct and uncontradicted evidence of defendant's witnesses was further and conclusively supplemented by plaintiff's own published literature, which showed that the plaintiff was itself using extensively, before Henderson's first conception of invention, as well as ever since, the Murray machine, containing everything which the plaintiff now seeks to ascribe to the Henderson invention, but nothing which either court has found to be within the Henderson patent. Plaintiff's published catalogues in evidence so conclusively sustain defendant's proofs as to make any argument on the part of plaintiff challenging these proofs, inexcusable.

If, as petitioner argues, the finding of the court which heard and saw the witnesses is to control, it is the end of petitioner's case, for both the court of the Eighth Circuit, which heard and saw the witnesses, and the Court of the Third Circuit, which heard and saw the

witnesses, found the patent altogether invalid. It was only by a divided opinion of the Court of Appeals of the Eighth Circuit, when the case was first before it, that there was read into the claims (improperly, we think) a limitation to the parallel placement of the hoists and absence of attachment to the timbers, and this held to be patentable invention and its use to constitute *contributory* infringement. This was apparently upon the assumption (now proved to be entirely false, and known by the plaintiff at the time to be false) that plaintiff's success in the business had depended upon the use of this parallel placement and absence of attachment. The proofs now show that plaintiff's success was obtained *exclusively* through the use of hoists antedating Henderson; that neither before nor since it acquired the Henderson patent has it manufactured its hoists or put them into use with this parallel placement, or with the cross timbers loosely laid upon the bottom of the U-frames (erroneously assumed by the first opinion of the Court of Appeals of the Eighth Circuit to be a forward step in the art), but that it has uniformly, since many years before the alleged Henderson invention down to the present time, adhered to the Murray type of construction, with the edgewise placement and positive attachment; and that this is, and has been, the substantially uniform practice in the use of such hoists. The evidence touching this is cited hereafter.

The *fifth* assignment is in effect that the Court of Appeals of the Seventh Circuit adopted the unanimous opinion of the Eighth Circuit (being that most favorable to petitioner) rather than that of the Third Circuit holding the patent altogether invalid.

The *sixth* assignment rests upon a fallacy, and the only error there complained of is one which petitioner procured and which, according to its theory, would be unduly favorable to it; that is, the inclusion of Whitney in the decree of the Seventh Circuit when the record showed that the Court of

the Eighth Circuit had exclusive jurisdiction of the controversy between plaintiff and Whitney. Conceding that there is no excuse for the Court of the Seventh Circuit including Whitney in a decree touching the very matter already decided as between him and plaintiff by the Court of the Eighth Circuit, which had prior jurisdiction of the controversy, it was at petitioner's request that he was so included and it can yet dismiss as to him. Plainly, when plaintiff had elected to sue Whitney in the Eighth Circuit and had carried its case to a decree there, it was not entitled to obtain the same relief against him in a subsequent suit. The bill in the Seventh Circuit, so far as it related to him should have been dismissed for this reason, if for no other, but plaintiff, who sought this relief against him, and who is still insisting upon it, has no grievance by reason of any error in including him in that decree. Whatever rights plaintiff asserted against Whitney under the Henderson patent having been adjudicated in the Eighth Circuit, where Whitney then resided and still resides, could not be made the subject of further relief against him in other circuits. Since plaintiff obtained a decree against him in the Eighth Circuit, he has never violated that decree in this circuit, or in any other circuit. Therefore, the Court of the Third Circuit was right in dismissing the bill against him, irrespective of any question of the validity or infringement of the patent, for the decree of the Eighth Circuit was, so far as he was concerned, a bar to such proceedings. The other defendants were not parties to the decree in the Eighth Circuit, were not bound by that decree, and were entitled to be heard in their own behalf. There is no such confusion or difficulty growing out of this situation as petitioner asserts. Whitney might well complain that he is made the subject of two decrees in different circuits, each for an injunction and accounting under the same patent, and relating to the same alleged infringement; but plaintiff, having procured this, and having the right to dismiss as to him

in the Seventh Circuit, cannot invoke a review by this court on such a pretext.

The *seventh* assignment is the allegation (entirely unsupported by proof, and in direct contravention of the evidence) that the subject of this litigation is of great importance to the building trade. Certainly the building trade has no interest that would be served by reopening this litigation or further continuing it. It has been greatly harassed and imposed upon by the pendency of these suits.

The files of the Henderson patent (R., pp. 225-235, especially pp. 232-235) show that the only pretense to invention upon which the patent was allowed, consisted in reducing the number of parts in the windlass platform hoist (an article that had long been in use for substantially the same purposes and in substantially the same way) by *forming the frame of the old hoist out of a single bar of bent iron and placing the bearings of the windlass in the uprights of this bar, instead of forming this frame of two or more parts secured together by bolts or other means*. Neither of the hoists charged to infringe in either case employed this feature or any approach to it, and the courts have held this was not invention. The old *Bowyer et al.*, patent (R., p. 333) had shown and described a platform hoist whose frame was a continuous U-shaped bar, on the bottom of which the timber rested, the windlass being carried in a bracket attached to this bar, precisely as it is in the "Whitney Scaffold Hoist" (the first Whitney), the difference being that the frame of the "Whitney Scaffold Hoist" is made in many parts secured together by bolts and rivets, instead of a single bar of bent metal. To escape this Bowyer anticipation, the claims were limited to treat the continuity of the uprights in which the bearings rested, and the formation of the several supports out of one bent piece of metal (features which neither of the defendants has ever used) as the essence of the invention. Other prior patents

had used this platform hoist for substantially the same purpose and in substantially the same way, but some of them without the continuity of the frame at the bottom. See *Sladek*, p. 337; *Harpin*, p. 359; *Crandall*, p. 381.

The *Murray patent* of May 28, 1907 (R., p. 387), under and in accordance with which plaintiff has manufactured continuously and extensively since 1908 (that is, prior to Henderson's first conception) used substantially the same character of windlass platform hoist in sets of four, arranged and operating precisely as in the Henderson, with the exception that the hoists were set edgewise to the wall, instead of parallel, and fastened to the cross timbers—an arrangement which is still adhered to in substantially all platform hoists.

When, in its first decision, the Court of Appeals of the Eighth Circuit assumed that plaintiff's substantially exclusive control of the market was evidence of the value of the Henderson invention, and that the parallel placement of the hoist and absence of fastening between it and the put-logs, was a controlling factor, it was misled into supposing that plaintiff's manufacture meant manufacture under the Henderson patent; whereas the facts now exhibited in the record, made especially prominent in the Philadelphia case, show that plaintiff knew this to be false, and that its manufacture was and is under the prior Murray, including both the edgewise placement and the fastening of the cross timbers to the frame.

Petitioner quotes defendant's witness Davidson (the organizer, first president, and long the active manager of the plaintiff company) as saying that the scaffold of the Murray patent was "practically junk." That this was known by him to be false at the time is abundantly shown by the fact that he, in May, 1908, organized a company for the manufacture of that platform, which has continued its extensive manufacture and sale, either directly or through licensees, ever since; that it has been the only platform hoist that plaintiff or its licen-

sees has manufactured as well since as prior to its purchase of the Henderson patent; that it has been, and still is, advertised by plaintiff extensively as the only successful platform hoist, it and the prior Cavanagh overhead hoists continuing to be the two types manufactured by plaintiff and its licensees. All these facts are shown by the cross-examination of Davidson himself and other of plaintiff's witnesses, and by plaintiff's published catalogues and the specific statements made therein concerning the extent of use and success of this Murray hoist, none of them showing or mentioning the Henderson machine, or any machine having what the courts have found to be the sole distinguishing feature of the Henderson. Plaintiff's catalogues, made exhibits in this case, are a complete impeachment of the assertion made by petitioner's brief concerning the Murray hoist. It was the success with which the Murray platform hoist was meeting, and its use in the construction of the La Salle and Blackstone Hotels in Chicago and other buildings, before Henderson had ever thought of contriving a hoist, that attracted his attention to this subject and led to his making the sketch upon which his patent was based. A Chicago contractor, Merrill, who was familiar with this Murray hoist and scaffold as put out under plaintiff's authority, irritated that he could not buy them and because plaintiff would only rent them at what he thought an exorbitant price, suggested to Henderson (patentee of the patent in suit) that he design a hoist which would not infringe plaintiff's patents. As a result of this, many months after this Murray hoist and scaffold had been used in Chicago and elsewhere, Henderson went and examined them as used under plaintiff's authority on the Blackstone Hotel, seeing about forty pair in use on that building, *corresponding exactly to plaintiff's Murray platform hoists as still made and advertised by it to the exclusion of the Henderson.* Dep. Henderson, R., p. 151, A. 1-78; p. 175, X-Q. 210; p. 176, X-Qs. 214-216; p. 211, A. 1-11; Defendants' Exhibits Nos. 14 and 13, pp. 293-295;

Defendants' Exhibit No.18, p. 303; dep. LaBelle (the scaffold builder who had charge of the erection and operation of these Murray hoists and scaffolds on the Blackstone), p. 199, A. 1-50; p. 206, X-Qs. 72-87; p. 208, X-Qs. 111-113; p. 209, X-Qs. 119-133; Defendants' Exhibits Nos. 1 and 2. These last two catalogue exhibits are issued and used by plaintiff and the "Patent Scaffolding Co." through which it makes and markets all its hoists. (R., p. 76, X-Qs. 16-72; p. 101, X-Qs. 117-129; p. 119, A. 7-29; p. 121, A. 41-47; p. 123, A. 52-84; p. 134, admission and A. 130-144; p. 138, A. 150-164; p. 144, A. 208-223.) The first in date issued considerably more than a year after plaintiff acquired the Henderson patent, and the second still later (see date August 12, 1912, p. 7, in smaller catalogue, and letter of August 25, 1913, in the other); they are, as shown by evidence and admissions above cited, the advertising catalogues of plaintiff and the Patent Scaffolding Company, which, under license from plaintiff, manufactures and distributes its hoists, plaintiff being only a holding company, whose manufacture and sale is carried on through the Patent Scaffolding Company.

Davidson (cited by petitioner as saying the Murray was *junk*) testified (R., p. 118, A. 1-14) that plaintiff had since its incorporation in May, 1908, been in the business of "furnishing scaffoldings"; that it was organized to do a business of "handling scaffolding"; that Plaintiff's Exhibit 15, made and marked under the Murray patent, represented the platform scaffolding device put out by it, pursuant to the purpose of its incorporation; that this Exhibit 15 had been known as the "Gold Medal Scaffold," because it was awarded a gold medal in November, 1910, on account of the record it had made in saving human life, no accident having occurred through any defect in "plaintiff's scaffold of the Murray type" (R., p. 119, A. 16-24; p. 120, A. 32-34; p. 121, A. 41-46); that the cut on page 10 of the catalogue Defendants' Exhibit 2 shows this Murray Gold Medal device as put out by plaintiff, incorpor-

ated for that purpose, from May, 1908; that he is quite sure (p. 122, A. 51-80) this is one of plaintiff's pictures (it is admitted, p. 134, that these were marked under the Murray patent 854,959, and that plaintiff has licensed the use of these Murray devices with this patent mark thereon. It is admitted, p. 80, that Defendants' Exhibit No. 2 was published by plaintiff "from 1912 on"); that Plaintiff's Exhibit No. 15 is known by the name of "Murray" and called the Murray by men working for plaintiff (p. 135, A. 130-131); that plaintiff holds the patents while the "Patent Scaffolding Company" operates under the patents, renting out the machine, by authority of plaintiff, and that the American Safety Device Company has taken over the business of plaintiff (p. 138, A. 156-162); that he is president of the Patent Scaffolding Company, and "that company is the operating company" under the patents owned by plaintiff, and, as such, has put out the circular Defendants' Exhibit No. 2, and that he is also president of the American Safety Device Company (p. 144, A. 208-214); that the gold medal circular was put out by the Patent Scaffolding Company considerably after November, 1910 (p. 145, A. 222-224); that plaintiff took over the Murray type of machine a good many months before the Cavanagh overhead machine and took over the latter toward the end of 1908 (p. 148, X-Qs. 243-244).

Plaintiff's witness *Cavanagh*, an employe of plaintiff (R., p. 76, X-Qs. 16-17), testified that when he went to work for plaintiff in 1909, it had a few of the platform hoist machines which it started to manufacture more largely in 1910, and had been pushing ever since; that it was the Murray machine shown in Defendants' Exhibit 1 (A. 24-28); that the catalogues in evidence as Defendants' Exhibits Nos. 1 and 2, show scaffold devices which plaintiff has been putting out generally since he has been with it (p. 77, X-Qs. 36-57)—plaintiff admits the catalogue in evidence as Defendants' Exhibit

No. 2 to have been published by plaintiff from 1912 on (top of p. 80) that the machines referred to as the Murray machines have been, and are, marked only under the Murray patent 854,959, and are placed at right angles to the building, with the put-logs attached by bolts or rivets, and always have been in general practice (p. 80, X-Qs. 61-64) that, while on special occasions where there is a "close alley" or a "building next door, where the iron put-logs have to come off," they "fit a plank in the alley and turn the machines around," "just lay a plank on the frame," the practice, except when limited space prevents, is to use the frames at right angles to the building with the put-logs bolted or riveted on, as shown in the exhibit; that they ship the put-logs with the hoisting machines, adapted to be put on as in this exhibit, and if any change is made, it is made at the building and because of the space conditions (p. 78, A. 41-52).

This plainly means that plaintiff's platform machines have only been put out in the form of the Murray, with the put-logs adapted to be bolted or riveted on parallel to the windlass, and that when the alley is too narrow to admit of their use with these put-logs, a pair of hoists are used with "*a plank*" extending between them, just as in the old Bowyer, Harpin and Sladek patents. It means, also, that plaintiff has from the outset adhered to the type of machine it was manufacturing before Henderson's first conception, which was the starting point of his departure, and which is still the only type of platform hoist manufactured by it or in its behalf, or by any of its licensees.

The only other witness called in behalf of plaintiff was French, the agent of the Patent Scaffolding Company, through which plaintiff manufactures and markets its machines. He testified that he had been agent for this company three years, and had been in the contracting and scaffold equipment business for about fifteen years, and saw the Murray machine corresponding to Plaintiff's Exhibit No. 15

in use in Cleveland in 1910 (R., p. 101, X-Qs. 117-123); that they distributed the circulars responding to those in evidence as Defendants' Exhibit No. 2, beginning in 1912 (p. 102, X-Qs. 129-132); that he was selling hoists corresponding to Exhibit 15 in 1910 (p. 103, X-Qs. 138-141); that an objection to the *windlass hoist* was that you "can go only so high at one jump," and that the highest that they could go at one jump was 100 feet (p. 108, X-Qs. 193-195); that the distance apart that the hoists are placed in practice depends upon the length of planking on hand (p. 112, R-D. Q. 241); and that the plaintiff's platform machines which he has handled have been marked under the Murray patent, as appears on the brass plate on Exhibit 15 (p. 114, A. 257).

The catalogues of the Patent Scaffolding Company (the company which, as licensee of plaintiff, has built and rented whatever scaffolding machines it has put out, and whose operations are, by the bill of complaint, treated as its operations) published and used by plaintiff (admission, p. 80), show that the invariable construction and use of plaintiff's platform hoist from the outset has corresponded to the Murray patent, and is identical with the Murray platform hoist which Henderson was sent to see when it was first suggested to him that he design one which could be used without infringing plaintiff's patents. These catalogues (which are, in effect, plaintiff's catalogues, and have been issued and used in its business exclusively since it acquired the Henderson patent) recite this machine as the "*Gold Medal Scaffold*," and as having been used in the construction in the La Salle and Blackstone Hotels, and many other buildings erected prior to the Henderson conception. They thus confirm the testimony of LaBelle and Henderson as to the identical construction of the machines used on those hotels. The smaller and earlier

of the two catalogues, Defendants' Exhibit 2, in describing this Murray gold medal machine, says in 1912 (p. 9):

"We have no statistics to show the number of lives which the ever increasing use of our scaffolding has saved during the period of more than five years since its introduction."

Davidson, apparently the author of this catalogue, president of plaintiff when it was organized to manufacture these Murray machines in May, 1908 (evidently after the machine had been sufficiently in use to attract attention and prove its merit), and now the president of the Patent Scaffolding Company, which is still putting out and using these catalogues and Murray hoists, is quoted by petitioner as asserting that this Murray patented machine was "junk." When asked to describe it as originally made, he excuses himself from doing so by saying that he was not "actively connected with the workings of this patent scaffold" (p. 148, A. 241); that he does not know just how it was made, paid little attention to it, and was not going into the construction of the machine (p. 193, A. 281-286).

That in 1909 Davidson knew that the plaintiff was then putting out the Murray machine exactly as it is still manufacturing it, and that it had been doing so for years, and that the only changes that had been made from the exact construction shown in the Murray patent to which he attached any importance, consisted in the *substitution of the ratchet arm for the crank that turned the drum*, is plainly shown by what occurred when he undertook to persuade Henderson that Henderson's hoist was bound to be a failure and to induce him, instead of putting it upon the market in ways that were cutting into the profits of plaintiff, to enter the employ of plaintiff and adopt its machines, renting them instead of selling them. In that interview, in October, 1909, Davidson, by previous arrangement, met Henderson, told him that plain-

tiff had used a device similar to the one Henderson was then putting out "and discontinued the use of it; that they had about 100 machines with the crank and gear drum, and it was impracticable, and also said we were cutting off our last opportunity and lower the price of scaffolds by selling the machines, and urged us to combine and form a monopoly, and wanted us to discontinue to use the machine we were then using" (the machine of the Henderson patent) (p. 159, A. 53-60).

Davidson, urging discontinuing the Henderson and using the Murray, said that the Henderson was "unsafe and unreliable" (p. 161, A. 61-63). Upon Henderson's refusing to agree to this, plaintiff brought suit against the Henderson Company, on Murray patent 882,206, and also against one of their vendees on Murray 854,939, which resulted in the Henderson Co. going out of business and assigning their patent to plaintiff. No Henderson device has been manufactured since. Plaintiff's claim that it revolutionized the art is the stock argument in favor of according patentability where there is no invention, and here it is based on falsehood.

It is plain that the only material departure from the construction illustrated in the Murray patent made in the Murray machine as actually built prior to the Henderson invention, as well as since, consisted in dispensing with the crank-driven gear (which the Henderson patent retained and relied on to distinguish it from the Murray as used) and in bolting the put-log to the frame more firmly and rigidly than shown in the Murray patent, which again would be a movement in the opposite direction from the Henderson. Both these changes, if not made when the first machines were manufactured for the market (as they probably were or plaintiff would have shown when the change was made), had been incorporated in the machine for more than a year before Henderson's conception of invention, and they have undergone no change since.

Plaintiff is in this dilemma—that whether or not it admits the Murray machines in use on the Blackstone and La Salle Hotels to have been made in exact accordance with the Murray patent, it is equally convicted of falsehood in its claim that these machines were “junk” until plaintiff was instructed how to make them by the Henderson invention.

The testimony shows without conflict that Henderson had seen plaintiff's Murray machines used in large numbers on the Blackstone Hotel prior to any conception of his hoist, and the catalogues put out by plaintiff recite this and the La Salle Hotel as those upon which its “Gold Medal” machine, illustrated in its catalogues and corresponding exactly to the description of LaBelle and Henderson, had been used. These catalogues also represent these machines to have been in successful use for five years prior to August, 1912, and to have been awarded a gold medal in 1910 for their life-saving record. The award of such a medal on such grounds carries at least presumptive, if not conclusive, proof that the machines must have been in successful use for some years prior to the date of the award, and the award was considerably before plaintiff acquired any right under the Henderson patent—after Davidson had insisted that it had tried and discarded the Henderson construction before adopting its Murray or “gold medal” construction. Plaintiff had under its control the means of proving when these Murray machines were first put into successful use, if the statement of its catalogue and of the witnesses who have testified for defendant were not true. Its representatives in Chicago and its records in its own office would have enabled it to have exposed any error concerning either the date or the character of the machines used on the Blackstone and La Salle Hotels. When this evidence was taken, the court offered to allow it to rebut it, and to give it leave to take depositions for that purpose, intimating that it would tax the defendant for the costs. Davidson was present,

and evidently knew that it would not be prudent to avail themselves of this leave for, after opportunity for consultation, plaintiff concluded not to undertake rebuttal. It would have been in its power to call witnesses instantly from its Chicago office and entries from its books to rebut this evidence, if it had been capable of rebuttal.

There is no doubt but that plaintiff's Murray machines, which Henderson saw at the Blackstone Hotel, and which LaBelle used both there and, before that time, on the LaSalle, were identical with plaintiff's platform machines of the present day, the only platform machines that it has ever exhibited as manufactured by it. Except the discarding of the crank and gear (which Henderson's patent retained), they differ from the Murray patent in no respect that would not be ordinarily incident to the manufacture of a patented device for the market, as distinguished from illustrating it in a patent. A patentee is not expected to illustrate the number of bolts that will be used in making an attachment, or the number of parts that will be used in the commercial manufacture of the frame. This is the work of the common artisan when he comes to building commercially under the patent. The Murray patent showed in Fig. 2 but one bolt used at each end of the put-log to attach it to the frame of the hoist. The manufacturer, in building the machine, has used two bolts instead of one, and has adhered to the common U-frame construction illustrated in some of the prior hoists, but has not changed the mode of operation or the relation of the parts by so doing. Plaintiff seems to argue that the use of the two bolts, instead of one, would have increased the freedom with which the put-log could tip relative to the frames, and permit one end of the put-log to rise in advance of the other. This is the reverse of the fact, for, if, as Davidson represented in his interview with Henderson (which is undenied, though Davidson was later on the stand), the Henderson construction was "*imprac-*

ticable," "unsafe and unreliable" (p. 159, A. 53-62), this was evidently because it permitted the free rocking of the put-logs relative to the hoist. Plaintiff had found, when it started to build the Murray machine, that it was prudent to reduce this tendency. This it had done by inserting the two bolts at each end, which, when the hoists were raised, would tend to reduce, *not to increase*, the rocking motion. With the single bolt at each end, there would be such free rocking motion as to endanger so tipping the platform sidewise as to dump whatever was on it and imperil the lives of those passing below—an objection which applied to a greater extent to the Henderson. Furthermore, if this free rocking motion occurred where there was no positive attachment, the put-log would slip off of its support and dump the platform and all on it. It was this positive locking of cross-log and hoist upon which plaintiff founded its claim of *safety* for the *Murray device*. Henderson found the same peril, and abandoned building his machines as shown in his patent, with no positive attachment between the cross-log and the frame, and *provided and used such attachment*, so applying it that it would tend to reduce the rocking motion (R., p. 187, A. 331-333), making holes in his frame through which he spiked the cross-logs to them.

Any intelligent, practical mechanic, building commercially under the Murray patent, would make the attachment sufficiently firm and allow as much or little play as was desired. The U frame, on similar platform hoists, supporting the timber so as to permit it to rock on its support, was already old. Undoubtedly the Murray was built from the outset substantially as it is still built. This is confirmed by plaintiff's catalogues. If it were otherwise, plaintiff could easily have shown it. This it deliberately avoided doing.

Every theory upon which plaintiff seeks to ascribe to Henderson any improvement in the art included in either of the Whitney machines rests upon a false assumption, and it

is significant that plaintiff has called no witness who admits himself to have been familiar with the construction and operation of the Murray machines at and prior to the time they were used on the Blackstone Hotel, to substantiate the theories upon which it bases its argument, though such witnesses were peculiarly under its control.

Appellee has argued that the Murray hoists which Henderson saw at the Blackstone Hotel were rigidly connected to the put-log. This is only a play on words. The evidence shows without contradiction that the construction was exactly that still used in plaintiff's hoists, and in commercial use since years before the Henderson invention. Henderson's explicit testimony to the effect that this was the construction when he carefully examined it with reference to getting his ideas for designing a hoist to serve the same purpose, some months before he made his first sketch, has already been cited.

LaBelle, an entirely disinterested witness, who had charge of putting up, operating, assembling and disassembling these machines when used on the Blackstone, and, prior to that time, when used on the LaSalle Hotel, described in his own language just how they were constructed and attached, and especially how the put-logs were connected with the hoists by the two bolts resting on the bottom of the U-frame (R., p. 199, A. 1-26; p. 202, A. 28-47). His statement (R., p. 210, X-Qs. 129-130) that they "had to tighten the put-log on the bottom of the U-frame" and his assent to a question in behalf of plaintiff about thus connecting the frames and put-logs rigidly, does not change this description a particle, but shows that the bolts were put in sufficiently tight to make a firm structure. If plaintiff's present construction (which, in this respect, is the same as that extensively used on the Blackstone and prior to that time) is a "rigid" construction, the Blackstone was rigid in the same sense, but in no other, for it was

identical. It was less yielding than the Henderson, and more firmly or securely attached, because experience had taught that this was desirable, any freedom or rocking motion or lack of stability in the platform being an element of peril. This witness refers, at the end of his testimony, to the fact that when the planks were put on, the frames could not "swing from one bolt to the other," which is the fact when the planks are put on exactly as shown in Defendants' Exhibits 13 and 14, pp. 293, 295, and also as shown in both plaintiff's catalogues. Those at the Blackstone, because constructed as plaintiff's have been uniformly constructed, both before and since Henderson's alleged invention, were rigid to the same extent and in the same sense only as the platform hoists made by plaintiff, under the Murray patent from about the time of its issue until the present day, and made *to the exclusion of the Henderson* since it acquired the Henderson patent.

Safety requires *avoidance* of tilting, not its presence, and *presence* of fastenings, not their absence.

The first definition of "rigid" in "Webster's New International Dictionary" is "firm," and it is in this sense evidently that the witness used this expression concerning this platform. If, as plaintiff would seem to contend, it were to be imagined, contrary to evidence, that the Blackstone hoists were attached by the single bolt, instead of two bolts, it would have been less rigid in construction than if provided with two bolts, and the falsity of plaintiff's argument that the construction was only "*junk*" would be quite as effectually exposed.

The files of the Henderson patent emphasize the limitations expressed in the claims, and show how explicitly these limitations *define the invention* asserted by Henderson. That the *reduction of the number of parts composing the frame* and the *exclusion of any attachment* between the part of the frame in which the windlass was journaléd and

the part of the frame which passed under the timber were insisted upon throughout as the very *essence* of the invention; that the contrast emphasized was between the "*built-up structure*" of prior hoist frames, in which there was some *attachment* between the *part of the frame carrying these bearings* and the *support for the timbers*; that the asserted invention consisted in forming the frame of a "*single bar of metal bent in the form of a U, the bent portion receiving directly and supporting, without the need for securing to it, the supporting member of the scaffold*" (Henderson files, R., p. 235), and that the *upwardly extending ends* of this *bent bar* "*receive between them and constitute the bearings for the drum of the windlass,*" were stated in the last argument leading to allowance as the essential distinctions between the hoists of the prior art and the Henderson. That the claims as originally drawn rested upon this, and the *peculiarities of the drum gearing*, and, after rejection, were specifically amended to emphasize this distinction, and that those capable of any broader interpretation were abandoned, is plain to one who carefully reads these files. The language of the claims retained explicitly *defines* the invention as restricted to this continuity of the *bent bar*, which both encircled the timber and *carried the bearings of the windlass in its upright arms*, thus excluding any attachment intermediate of the part in which the drum was journaled and that on which the timber rested. See, particularly, rejections, amendments and arguments, R., pp. 232-235.

In the first argument after rejection on prior patents (p. 233), stress was laid upon the reduction of the "*number of members*" in the "*chain of parts*" between the "*primary support*" (the windlass upon which the hoist was carried) and the *scaffold*, by *excluding connections* in this "*chain of parts,*" it being insisted that, by thus forming the frame out of a "*single bent U-shaped bar,*" all "*connecting rivets,*

bolts or other auxiliary means" were dispensed with and the hoisting mechanism "mounted *directly between the ends* which thus extend from the beam, and the desirable security is *thus* effectively realized." It was urged that the claims specified that the "metal bar is formed *around the beam*" and that the claims had been *amended to further specify* that "*the metal bar is bent to directly carry and support the beam.*"

The contrast between thus forming the structure out of a "single bar of bent metal," as distinguished from the "frame of built-up structure," is still more explicitly dwelt upon in the last argument (p. 235). The language of the claims expressed as definitely as words could the limitations thus dwelt upon. It was the exclusion of all "*connections*" between the part of the frame in which the bearings of the windlass rested and that which passed around the timber, and the substitution of "*a continuous U-shaped metal bar,*" which both extended around the under side of the beam and rotatably supported in its upright arms the "*hoisting drum,*" and thereby avoided any interposed "*connections*" between the bar in which these two bearings rested and the support of the timber and *reducing the number of parts*, this "*single bent bar*" affording in itself the three points of support, that was relied upon to avoid the dangers and inconvenience charged against the built-up frame (meaning frames built up after the manner of the Whitney, as plainly indicated by the prior art from which this language was differentiated); and it was upon the theory that the invention consisted in just this that the Examiner was finally persuaded to allow the claims. The Examiner from the outset had recognized, and the solicitors conceded, that the Murray patent showed every feature asserted, except the *continuity* of the single bent bar directly carrying, without interposed connections or bolts or fastening devices, the hoist drum and the timber. Several

of the prior patents on similar hoists showed them used in pairs with the timbers resting between the upright arms upon cross supports attached by bolts. The Bowyer patent had shown the bent frame with the timbers resting upon the U, but there was an *attachment* between the upright arms and the bracket arms which carried the windlass, making it necessary to lay stress on this *continuity* of the single bar which afforded the three points of support, the *reduction* in number of parts, and the absence of attachments. The Examiner had held that there would be no invention in supporting the cross timbers of the Murray in the same way that they were shown as supported in the Bowyer. This was not disputed by Henderson's solicitors, but they insisted that neither of the prior devices showed the timbers resting upon a *single continuous bent bar* which carried *directly* in its upper arms the bearings for the hoist, and that the *simplification* and *avoidance of connections* thus secured constituted a patentable invention where the interposition of any joint or attachment between the bearings of the hoisting drum and the support for the platform was objectionable. It was in differentiating from both Bowyer and Murray that these distinctions were so insisted upon. In Bowyer, the bearings of the drum did not rest in the "*single bent bar*" which passed under the timbers, but were carried in separate bars *attached to* these bars, so that while it had the U frame carrying the timbers, there were "*connections*" interposed between the support of the timber and the support of the hoist; and the language of the claims and arguments treated this as a *vital distinction*. These distinctions were carried into the claims and insisted upon as the ground for asking the allowance of those finally coaxed out of the Examiner. *All these distinctions, so emphasized in obtaining the Henderson patent exclude both forms of Whitney hoists more plainly than they do the prior hoists from which they sought to differentiate the*

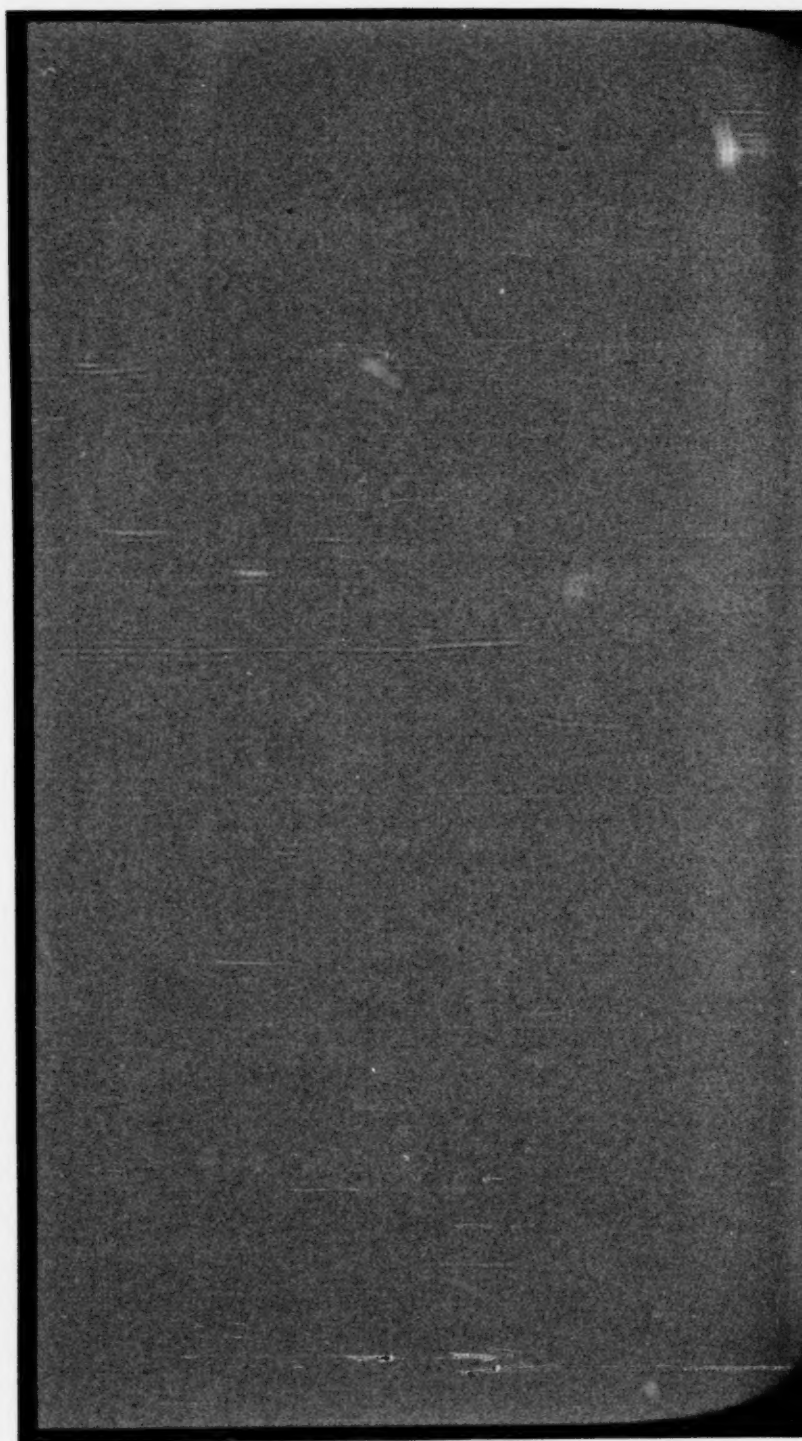
Henderson. It would appear from the original claims and specification that Henderson never asserted any invention that was not thus limited, and that the amendments and arguments, and abandonment of the earlier claims, were intended to *further emphasize this distinction* and satisfy the Examiner that the claims were explicitly limited to such construction. If, as has been held by the several courts passing on this case, there was no invention in making the U frame of one piece, it follows that the patent in suit is invalid, not, as contended by petitioner, that this, the only pretended invention on which the patent was granted, can be disregarded for the purpose of finding infringement.

The decisions of all three Courts of Appeal agree in holding that petitioner is not entitled to the relief he is now asking, and six judges have held his patent altogether invalid.

Respectfully submitted,

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I.

Misstatements and perversions of fact in respondent's brief.

1. (P. 1-2.) There is no truth in the statement that, "all the judges of all the Circuit Courts of Appeal who have passed upon this patent have been unanimous in holding that the patent could not be sustained as covering what petitioner now asserts to be the invention of the patent, viz., a 'loose jointed connection between the putlog and the supporting frames' of the hoist."

Petitioner never asserted *the* invention of the patent to consist in a "loose jointed connection between the putlog and the supporting frames," no Court has passed upon that question, and consequently there has not been a holding of any kind in relation thereto. The invention of Henderson resides in his *combination*.

2. (P. 2, Par. 2.) There is no truth in the statement that, "There is entire unanimity in all the circuits in holding the patent cannot be sustained as covering what plaintiff now asserts as the patented invention."

There is no truth in the statement that, "Its present argument is, in effect, that plaintiff's use of the Murray hoist and platform positioned and operating as in the prior Murray patent of May 28, 1907, is the invention of these claims."

The suggestions contained in the last half of that paragraph, are too absurd for serious consideration.

3. (P. 2, Par. 1.) It is not true as stated, that the Court of Appeals of the Eighth Circuit, "enjoined the use of the first Whitney hoists *when used parallel to the wall*, though expressly authorizing their use when their planks were laid on the lower bars of the hoist frame and these frames were placed *with their edges to the wall*" (L. B. Rec., 6 to 16).

Judge Sanborn's concluding paragraph permitted the defendant to use the machines edgewise, only when two machines were used, but restrained any combination of *four* or more whether used, edgewise or broadwise, nothing of this nature being stated in his concluding paragraph, which concluding paragraph begins, "Let a decree be drawn (224 Fed., 452).

4. (P. 3, middle of second par.) There is no truth in the statement that the plaintiff "had since over a year before Henderson's alleged invention, down to the present date, manufactured under and in accordance with the prior Murray patent of May 28, 1907."

There is not a word of testimony in the case that the petitioner manufactures a scaffold having the riveted connection between the putlog and the hoisting frame shown in the Murray patent. On the contrary, the testimony shows conclusively that that construction of the Murray patent was abandoned and has not been used by the plaintiff for years.

5. (P. 5, top of page.) So far as any meaning can be extracted from this paragraph, it is absolutely without foundation in truth or in fact.

6. (P. 5, Par. 2) There is no truth in the

statement that the only interpretation upon which any judge has found invention in the Henderson patent, is one requiring the edgewise placement of the hoist. Judge Sanborn, in his opinion, spoke of a broadside arrangement and not an edgewise arrangement.

7. (P. 6, Par. 2.) There is no truth in the statement that, "Sometimes these cross timbers had rested directly upon the bottom of the U-frame, sometimes they were shown as attached to the bottom by bolts, and sometimes as resting on the bottom without such attachment, sometimes as resting on an attached cross bar at the bottom of the frame," as stated in respondent's brief.

8. (P. 7, lower part of page.) There is no truth in the statement that, "After all his claims had been rejected upon the Murray, Bowyer and Casperson and other prior patents, his solicitors struck out his original claims and limited the specification and claims." The statement is particularly false, in that, the specification was not limited nor was the original claim struck out.

9. (P. 8, Par. 3.) There is no truth in the statement that, "all three of the Courts of Appeal which have passed upon this patent, have been unanimous in holding that these improvements, which were the sole pretext for allowing the patent (as abundantly shown by specification, claims and the proceedings in the Patent Office) did not constitute patentable invention in view of the prior art."

10. (P. 9, Par. 1.) There is no truth in the statement that "On appeal, one of the circuit judges agreed with him, the other circuit judge and the

district judge sitting with him, while distinctly holding that the features upon which the claims were allowed and to which they were in terms restricted, did not constitute patentable invention." The Court made no such holding.

11. (P. 11, Par. 1.) There is no truth in the statement that in the Circuit Court of Appeals for the Eighth Circuit, "The other circuit judge and one district judge—who had not heard the evidence—held that what the patent represented to be the invention of the patent was not patentable."

12. (Pp. 11-12.) There is no truth in the statement, "Since the evidence has exposed the fiction by which the first decision of the Court of Appeals in the Eighth Circuit was procured, plaintiff has repudiated the interpretation of the patent upon which that decision rested and has sought to assert the patent as covering a 'loose-jointed connection'."

The loose-jointed connection is composed of two elements, the claims of the patent in suit are composed of *several* elements. It would be simply foolish to claim that the use of two elements of the claims would cause infringement.

Petitioner claims that the loose-jointed connection is *inherent* in the construction of a stirrup and the engaging end of a putlog, as much so as in the case of a stirrup of a saddle and a foot placed therein.

13. (P. 11, Par. 1.) There is no truth in the statement that the Circuit Court of Appeals for the Eighth Circuit "sustained the patent as covering the first Whitney hoist when used with the frame parallel to the wall, but excluding it when the hoists were hung edgewise to the wall."

This is not true, as Judge Sanborn's concluding paragraph did not permit the defendant to use two pair of hoists edgewise to the wall, but permitted them only to use *one single pair* of hoists *edgewise* to the wall with the plank parallel to the wall (as shown in the prior art Bowyer patent).

14. (Pp. 16-17.) The statement, "the business was conducted under and in accordance with the ~~prior~~ Murray patent, and that plaintiff's hoists had not been modified in construction or placement since Henderson saw them before the earliest date claimed for the conception of his invention," is contrary to the record.

When Henderson first saw the structure of the Murray patent the putlogs were *rigidly* secured to the frames. That fact was very well known to respondent's attorney because it was placed upon the record by respondent's own witness La Belle (Rec., Chain Belt Company case, p. 174):

"XQ129. Those first machines you testified about, at the Hotel Blackstone and Hotel La Salle, were made as tight as possible between the putlogs and frames, were not they, as you testified on your direct examination? What do you mean by tight? A. *We had to tighten them. We had to tighten the putlog on the bottom of the U-frame.*

"XQ130. So that the putlogs and frames were *rigidly connected* with each other? A. Yes, sir.

"XQ131. No doubt of that in your mind? A. No."

15. (P. 24.) There is no truth in the statement beginning at top of page:

"This patent, entitled for 'Improvement in Adjustable Scaffolds,' is that under and in accordance

with which plaintiff has made all its hoists since the date of that patent and had put many thousands into use prior to Henderson's alleged invention, never modifying them to adopt any feature of Henderson's after obtaining his patent in 1911."

The statement is untrue, first, for the reason that, as far as appears, the petitioner did not own the Murray patent "since the date of that patent" and consequently could not have put out any machines under the patent prior to the time it acquired it, and the statement that the petitioner never modified them to adopt any feature of the Henderson after obtaining his patent in 1911 is not in conformity with the record. Petitioner at one time actually tried to use the Murray device with the putlogs or crossbars *rigidly* connected with the machine frames but that construction was found to be impossible and was modified by adding to it the loose-jointed connection between the putlogs and the hoisting frame found in the Henderson patent. As stated by the witness Davidson, in the Chain Belt Company case (p. 160):

"Q284. And the Murray machines used by you at that time, prior to 1909? A. We was using the machine of the rigid type, like that patent."

Again (Rec., p. 158):

"A. Our machines did not operate as we hoped they would.

"Q270. Which ones do you mean now? A. I mean the Murray.

"Q271. Overhead? A. Murray overhead we did some business with. The Murray riveted rigid machine it was very hard to put on the market.

"Q272. I don't just get what you mean.

What do you mean by the Murray riveted machine? A. That is the Murray patents of 1907 machine which we took over and which we expected was going to be a better machine than—would compete with the overhead, but in that we were disappointed, because it was practically *junk*, and of course we were experimenting, and our people in the shop were working continually on these machines and operating what would operate.”

Again (Rec., p. 159) :

“Q280. What machine bothered you—gave you that trouble? A. Why, we had a rigid frame—originally we had an overhead—and they both gave us that trouble.”

16. (P. 24, Par. 1.) There is a malicious character to the misstatements of fact specified in the statement, “This patent entitled for ‘Improvement in Adjustable Scaffolds’ is that under and in accordance with which plaintiff has made all its hoists since the date of that patent and had put many thousands into use prior to Henderson’s invention, never modifying them to adopt any feature of Henderson after obtaining his patent in 1911.”

That statement has been made, repeated and reiterated in respondent’s brief, notwithstanding, as we have already pointed out, that respondent’s own witness La Belle testified that the structures he saw as placed upon the market had the cross beam or putlog *rigidly* secured to the machine frame.

17. (P. 24, middle of page.) There is no truth in the statement that “the Murray U-frames were inverted, and the cross timbers are made of angle

iron and *pivotally* attached to the lower end of the frame, by bolts or rivets."

There is no truth whatever in the statement or suggestion that the Murray patent shows cross timbers "pivotally attached" to the lower ends of the frames.

18. (P. 25, Par. 2.) There is no truth in the statement that the "witness Cavanagh testified that 70 per cent. of the trade were using these Murray machines." What the witness testified to was (L. B. Rec., p. 63):

"Q. What is that type of machine there— isn't it *called* the Murray platform machine?
A. That's what we call it *now*."

The statement, at the end of the second paragraph 25, to the effect that the Cavanagh hoist "apparently represents the other 30 per cent.," finds no support in the record. The record shows that the 70 per cent. of machines used throughout the country embodying the loose-jointed connection between the machine frame and the putlogs are licensed by the New York Scaffolding Company. The other 30 per cent. represent what is made by all the other scaffold manufacturers throughout the country. What those constructions are does not appear in the case.

19. (P. 25, Par. 3.) There is no support in the record that "Plaintiff's witness Davidson testified (L. B., Record, pp. 41-54) * * * that this Murray type of scaffolding was on the market in 1908 at the time they formed the company; that they started the company to make it with the U-shaped frame and the putlogs at the lower end and the hoisting device by which it was lowered

and raised, and have been putting it out ever since, and are still doing so." That witness testified, referring to Defendant's Exhibit 3, pp. 10, 11 and 13, Rec., p. 48 (Liebel-Binney case):

"Q. Well, how long have you been putting out the device shown on these three pages? This is the Murray type of construction, isn't it? A. That is the *general Murray* type.

"Q. That is the type that you have designated here as the Murray type, isn't it? A. I say that this type here looks to me like our early Murray type (witness referring to page 13 of Exhibit 'C'). I say that here are machines—this is a very much later picture. We are handling this part of the machine differently. (Witness refers here to pages 10 and 11 of Exhibit C).

"Q. Well, the type that is shown on pages 10, 11 and 13 is the type that you have referred to in your direct examination as the later Murray type? A. I referred to this type (page 13) because I know this is an early picture. This type, on pages 10 and 11, we are improving. And this is the type of The Patent Scaffolding Company.

"Q. Well, what is that type? Under what patent is it made, do you know? A. I don't really.

"Q. How does it differ from the Murray type of device, just where, in what refinement? I am speaking as to how this construction shown on pages 10 and 11 differs, if at all, from that shown on page 13, either in use or in construction. A. Well, I believe that this one shown on page 13 is a *riveted structure right through here (pointing to the putlog) underneath; and this later type isn't*. You can make that any width or turn it any way. And this is separate, handled separate and shipped separate (witness indicating putlogs on pages 10 and 11).

"Q. The one that you call the Murray type is shown in Murray Patent No. 854,959, isn't it? A. Well, if that is *securely* bolted, I imagine so. These are fine points. I don't qualify as an expert, because I am not.

"Q. If I understand you correctly, in the Murray type of hoisting mechanism there was a bottom member with two upwardly extending side members, to the latter of which the drum was rotatively attached. Isn't that so? A. My understanding of the early type was that there was a piece *riveted right across there* and made the putlog at the bottom of the machine."

* * * *

"Q. And you started at that time" (1908) "putting out this Murray type of device, with the U-shaped frame, with putlogs and at the lower end a hoisting device by which the device was lowered and raised, did you? A. At that time it was the Murray device that we first started to handle.

"Q. And you have been putting that out ever since? A. Except that we have *improved* our service and *machine*."

Again, on page 52:

"Q. The Murray device is giving satisfaction under your lease, isn't it? A. We think we have been getting pretty good satisfaction ever since we have started. We have revolutionized the business.

* * * *

"Q. Well, do you mean by the Murray type a structure like that shown in the Murray patent 854,959, or do you mean a structure like that shown on page 11 of the booklet, Defendant's Exhibit 'C'? A. Well, now. I mean this scaffold, this machine. This is what we are doing. (Witness indicates page 11 of Defendant's Exhibit ('C'))."

That shows a different *construction* from what is shown in the Murray patent.

20. (P. 26.) From the testimony last quoted, it appears obvious that there is no truth whatever in the statement made in the second paragraph:

"Plaintiff made no change in its construction of hoists after acquiring the Henderson patent. * * * It has adhered strictly to the Murray machine as made and extensively used by it * * * conforming in every material respect to that patent."

The persistence in which that perversion of the facts, in respect to the connection between the putlogs and the hoisting frame of petitioner's device has been pressed upon this Court cannot be said to arise from inadvertence, accident or mistake, but is obviously employed, in a determined effort, to mislead the Court in that respect.

21. (P. 27, middle of Par. 2.) The statement that the device put upon the market by the petitioner under the Murray patent "has undergone no material change since first put upon the market" is absolutely false.

The witness Davidson testified, in reference to the Murray type of machine first placed upon the market (L. B., Rec., p. 49):

"My understanding of the early type was that there was a piece *riveted* right across there and made the putlog at the bottom of the machine."

In the Chain Belt Company case the same witness was produced as a witness for the respondents and testified, in relation to the change between

the earlier and later Murray constructions as follows (C. B. Rec., p. 158):

"Q263. Give the date when they started to put out your devices approximately like Exhibit 15.

"Q264. The earliest date. A. Early in 1910."

"A269. Our machines did not operate as we hoped they would.

"Q270. Which ones do you mean now? A. I mean the Murray.

"Q271. Overhead? A. Murray overhead we did some business with. The Murray riveted rigid machine it was very hard to put on the market.

"Q272. I don't just get what you mean. What do you mean by the Murray riveted machine? A. That is the Murray patents of 1907 machine which we took over and which we expected was going to be a better machine than—would compete with the overhead, but in that we were disappointed, because it was *practically junk*, and of course we were experimenting, and our people in the shop were working continually on these machines and operating what would operate, and that was the overhead machine."

"Q280. What machine bothered you—gave you that trouble? A. Why, we had a *rigid* frame originally we had a overhead and they *both* gave us that trouble."

"Q284. And the Murray machines used by you at that time, prior to 1909? A. We was using the machine of the *rigid* type, *like that patent*.

"Q285. Can you state what you mean by rigid machine? A. I have an understanding the Court does understand.

"By the Court: I understand Mr. Davidson to explain it the other day as a matter of *rigid bolting*.

"Q286. Of those old machines, was not there a U-shaped frame? A. I think not. But I am not going to go into the construction of the machine.

"A. *It was rigidly bolted.*

"Q287. How was it rigidly bolted? That is what I am trying to find out if I can. A. There is two pieces come down, as I understand it, roughly, and this piece goes right across, forms a putlog and is *rigidly* bolted to those two frames. That is, roughly, the way I understand it."

Respondents well know that the record shows that the petitioner has not used such a rigid construction for a number of years past.

22. (P. 27, par. 2.) There is no sense in the statement, "The catalogue under and in accordance with which (*sic.*) plaintiff's scaffolds are built," nor in there any truth in the statement that such catalogue published August 12, 1912, described the present structure as used prior to June 12, 1909, the date of Henderson's application for patent.

23. (P. 27, last par.) The record does not support the statement: "plaintiff has always used, in the manufacture of this Murray machine, the frame having the U at the bottom instead of at the top, as illustrated in the Murray patent, with the bolts or rivets which connect the 'putlogs' with the frame *resting* on the U."

The witness testified in the Liebel-Binney case (p. 63):

"Q. The type of machine that you have been speaking about is the one shown on this circular, Defendant's Exhibit 'C,' on pages 10, 11 and 13 is it not? A. Yes, it looks like the machine.

"Q. This is the kind that you have been installing during that time, is it? A. During what time?

"Q. Since you have been with the New York Scaffolding Company? A. Yes, sir, since I have been with the company.

"Q. And that was since 1910—what time in 1910? A. I went with the company in August.

"Q. And they were using that device at that time? A. *Not when I first went there.*

"Q. What company was using it at that time? A. I don't know.

The witness Davidson testified in the Liebel-Binney case (p. 49):

"Q. If I understand you correctly, in the Murray type of hoisting mechanism there was a bottom member with two upwardly extending side members, to the latter of which the drum was rotatively attached; isn't that so? A. My understanding of the early type was that there was a piece *riveted* right across there and made the putlog at the bottom of the machine."

That shows positively that when the Murray device was first used by petitioner the frame supporting the hoist device did not have a U construction at its lower end but had the cross bar *riveted* to the lower free ends of the side bars of the machine frame as in the Murray patent.

There is no truth in the statement made at top of page 28 of respondent's brief to the effect that the catalogues represent the machines as in use for years before the Henderson application. The catalogues were printed in August, 1912. The Henderson application was made June 12, 1909. It is absurd to suggest that a catalogue published in

1912 could represent machines as in use for years prior to 1909, and it is likewise absurd to suggest, page 28, the witness Davidson as authority for the statement that the machines were so built at the outset, in view of the fact that Mr. Davidson testified in the Liebel-Binney case (p. 49) specifically that the Murray machine when first used had a piece *riveted* across the ends of the side bars of the hoisting machine frame so as to form a putlog at the bottom of the machine, an entirely different construction from that stated as comprising a frame having a U at the bottom instead of at the top with the putlogs resting on the U.

24. (Pp. 29-30). This record does not show that the Murray machines as shown in the catalogue, Defendant's Exhibit C, had been made and leased by the petitioner two years or so prior to the award of the medal and the witness Pitou does not so state. His testimony in the Liebel-Binney case, page 35, is as follows:

"Q. And for how long a time prior to the award of November 21, 1910, was the Patent Scaffolding Company leasing the device shown on these pages of the circular?

"This is objected to by counsel for plaintiff as going far beyond the cross-examination. This device is not in this case.

"The Court: I will overrule the objection and let the evidence in, and note an exception. That is pages 10, 11 and 13.

"A. *Previous to that time the device was made in a different way.*

"Q. How long prior to that time were they made, so you could get an award on it? They

must have been in use for some time, or you couldn't have got the award, could you? A. That is correct.

"Q. Well, how long had they been in use prior to November 31, 1910, as shown in these cuts, and leased by your company? A. Two years or so.

"Q. At least two years. That is, as early as November, 1908? A. Not exactly that same form; not without *modification*. Our devices had been in use for two years previous to that time to receive this award, but they hadn't been used *in the manner they now use them*.

"Q. How do they differ? A. Previously, when we first issued our devices, they were *irremovably riveted together*.

"Q. They weren't riveted together in 1910? A. No, sir.

"Q. And not in 1909? A. Well, I would say *a short time before the awarding*, the irremovable riveting had been removed. Before that they had been riveted."

25. (P. 50, Par. 2.) There is no support in the record that, "The reason why plaintiff and its licensees have never manufactured a Henderson hoist, have confined their manufacture of scaffold hoists to the Murray," etc. The plaintiff has never confined its manufacture of scaffold hoists to the Murray patent construction. There is no testimony in the record supporting the other allegations contained in that paragraph.

26. (P. 51.) There is no support in the record that, "In the Whitney, as used, the side rods pass through holes or notches in the cross-timbers, and the cable through a hole in the center and through the bottom of the frame, and then tie them *snugly* in place so that they cannot be removed without lowering them to the ground."

There is no testimony in the record sustaining that statement in any way; on the contrary, the record shows that there is not a snug or rigid fixing, but a putlog is *pivottally* placed on the bottom bar of the U-shape frame.

27. (P. 52, Par. 2.) There is no truth whatever in the statement that, "The catalogues under which plaintiff's hoists are sold * * * adheres to the same *attachment* and to the same arrangement of hoists that had been shown in the Murray patent."

The catalogue, page 11, does not show a rigid connection between the putlog and the hoisting frame but the Murray patent shows a *rigid fixed* connection between those parts.

(Same Par.) There is no truth in the statement that "plaintiff's evidence shows the Murray to have been extensively on the market long before that, and to have retained control of the market since, *with no change of any kind since plaintiff acquired the Henderson patent, and no material change since the Murray patent issued.*"

The statement is absolutely untrue because it conceals the fact that petitioner was obliged to abandon the *rigid* construction of the Murray patent and substitute a *flexible* connection between the frame and the putlog, and under those circumstances, the petitioner, in order to protect itself, purchased the Henderson patent and paid his company ten thousand dollars therefor (Chain Belt Co. Rec., p. 135).

28. (P. 53, Par. 2.) There is no truth, no sense, and little intelligence in the statement, "Petitioner has argued that defendant's disputing the validity of the patent is an admission of infringement."

29. Page 63, Par. 2. Maintains the same persistent effort that has been made all through respondent's case to mislead the Court into believing that the original Murray patent had a loose-jointed connection between the hoisting frame and the putlog.

The statement that, "This is the construction of Murray used under plaintiff's authority in building the walls of the Blackstone Hotel in Chicago in the Winter and Spring of 1908-09" is discredited by the testimony of respondent's own witness La Belle (Chain Belt Co. Rec., p. 174) :

"XQ129. Those first machines you testified about, at the Hotel Blackstone and Hotel La-Salle were made as tight as possible between the putlogs and frames, were not they as you testified on your direct examination? What do you mean by tight? A. We had to tighten them. We had to *tighlen* the putlog on the bottom of the U-frame.

"XQ130. So that the putlogs and frames were *rigidly* connected with each other? A. Yes, sir.

"XQ131. No doubt of that in your mind? A. No."

30. (P. 64, Par. 2.) There is no truth in the statement that "This Murray construction which Henderson had seen before conceiving his supposed invention is identical with what petitioner now asserts embodies the invention covered by the two claims in suit."

We have already pointed out that the construction that Henderson and La Belle saw at Chicago had a *rigid* connection between the machine frame and the putlogs. The construction petitioner now asserts embodies the invention covered by the two

claims in suit has a *loose jointed and free connection* between such parts, in combination with the other elements of the claims, all as used by respondent.

There is no truth in the statement following that the Murray construction which Henderson had seen before conceiving his invention was identical with that shown in plaintiff's catalogue put out in August, 1912. Even Henderson, who after receiving valuable consideration for his patent, showed a malicious desire to destroy his own patent, did not dare to suggest that the construction of device he saw at the Blackstone Hotel in Chicago had a *loose-jointed* connection between the putlogs and the hoisting frame, but La Belle makes the matter very positive by stating that the connection between the hoisting frame and putlogs was *fixed and rigid*.

31. (P. 67.) The statement, "'Junk' is the term that Davidson had applied to the Henderson hoist while extolling the greater merits of the Murray" is absolutely false. The absence of any reference to any testimony supporting that statement adds significance to its falsity. Mr. Davidson testified (Chain Belt Co. Rec., p. 158), that the Murray *riveted* machine was taken over by the Company expecting that it would compete with the overhead machine, "but in that it was disappointed because it was practically junk."

31. (P. 67, Par. 3.) The statement that "the Murray patent plainly shows a construction that would result in a loose joint" is absolutely false. There is no testimony to support that statement and respondent knew very well that it would not be possible to support such a statement.

32. (Pp. 67-8.) The statement that, "The evidence is overwhelming to the effect that it had all the play prior to the Henderson that it has had since," is entirely false in every respect. There is not a scintilla of evidence in the case to that effect. On the contrary, as has already been referred to on pages 29 and 30 of petitioner's brief, the Murray machine with the putlogs *riveted* to the ends of the hoisting machine was not a success and was abandoned. It should be borne in mind that the word "Murray type" of machine, as used in this case by both petitioner and respondent, refers to the *general* type of the entire scaffold, with hoisting mechanism arranged on the platforms instead of on outriggers projected outwardly from the top of the building. But the records are clear that the Murray *patent* machine was irremovably rigidly riveted, and the Henderson and its successors, petitioner's commercial machines, have the *loose-jointed* combination.

II.

Refutation of respondent's Appendix to respondent's brief.

This appendix is composed of pictures and statements, some of which have no basis in the record at all.

So, for instance, page 11 is entitled "Common form Swinging Scaffold used for more than twenty-five years. Perspective view of Bowyer and Casperson Patent No. 382,252, May 1, 1883." No citation to the record is even attempted to be made by respondent to support this misleading statement. There is no evidence in the case of the Bowyer, *et al.* patent ever having been used. It is a paper patent only. The picture of page 11 of the appendix is not like the Bowyer patent, as the picture shows five platform planks side by side, whereas the patent shows only one narrow plank. The intention of respondent was to mislead, since the picture of page 11 gives the impression that the platform is wide and long to enable men to walk and work on it. The Bowyer patent (Chain Belt Rec., p. 332 and Liebel Rec., p. 185) shows only one plank in Figure 2. The Bowyer patent says on its second page, the "arm W passes over the end of the plank B, *close to the upper side thereof*," and acts as a "*retaining bar for the stage plank*." As far as the record shows, this Bowyer structure has never been used. The statement on the top of page 11 of respondent's Appendix, "used for more than twenty-five years," as shown in the picture finds not an iota of testimony in the records.

Pages 2 and 3 are also misleading. The pictures

there shown are copies of drawings made by counsel and offered in evidence in the Chain Belt case (Chain Belt Rec., p. 131) and the witness saw them for the first time while he was on the stand (Chain Belt, p. 140; XQs156, 157 and 158)), and while the witness La Belle says the alleged prior structures were like the drawings (Chain Belt Rec., p. 169, Q46) he, when speaking of the structures themselves (on p. 174), said:

"XQ129. Those first machines you testified about, at the Hotel Blackstone and Hotel La Salle were made as tight as possible between the putlogs and frames, were not they as you testified on your direct examination? What do you mean by tight? A. We had to tighten them. We had to *tighten* the putlog on the bottom of the U-frame.

"XQ130. So that the putlogs and frames were *rigidly connected* with each other? A. Yes, sir.

"XQ131. No doubt of that in your mind? A. No.

"Redirect examination:

"XQ132. What do you mean by rigidly connected together? A. We connected them before we hung them. They came in parts, we had to fasten the putlogs on the bottom of the U, and then hung them and put the plank on afterwards.

"XQ133. Could the frames when you elevated them with the pipe by turning the windlass, *swing from one bolt to the other*? A. No, sir."

And the other witness, Henderson (Chain Belt Rec., p. 139, XQ139), when being shown these drawings said the Blackstone machines were iden-

tical with the drawings (Chain Belt Rec., p. 130, Q40), but says on cross examination, Record, page 137:

"XQ140. Well, but you don't know as a fact, do you, whether those bolts were screwed on tight or were loose? A. No, I do not."

And in answer to a question by the Trial Judge (Rec., p. 143, Q192) he says he "didn't know" how they were fastened.

The statement on the top of page 2 of the Appendix asserts that structures like the pictures "were used by plaintiff in 1908 and subsequently," referring the Court to the testimony of Henderson and La Belle. But the above brief quotations from the testimony show the character of the testimony adduced to support the statement made by respondent. The Trial Court who *heard and saw* these witnesses (see *Davis v. Schwartz*, 155 U. S., 631, 636), disregarded their testimony as it did not impress him, and plaintiff considered it so weak and so full of contradictions that it urged that it did not come within the requirements as stated by this Court in the Barbed Wire patent case, 143 U. S., 275, 285; and in *Deering v. Winona Harvester Works*, 155 U. S., 286, 301).

Also in *Taigman v. Forsberg*, 223 Fed., 787 (C. C. A., 2nd), the Court of Appeals held that weak and insufficient prior use testimony requires no rebuttal.

The statement of respondent also says: "See pages 10, 11 and 13, Scaffolding Co. Catalog, Defendant's Exhibit 2," but this picture on page 2 is not shown in the Catalog, Exhibit 2 or Exhibit C.

The statement also says: "Also Murray patent of 1907." If the picture is supposed to show the Murray patent (Chain Belt Rec., p. 384) it is clearly inaccurate in many respects.

Similarly, on page 3, it is said: "End view Murray type swinging scaffold as used by Patent Scaffolding Co., and plaintiff in 1908. See Defendant's Exhibit No. 14, Chain Belt Case (713), opposite page 236, and testimony of Henderson and La Belle. Same structure as on preceding page." We have already shown the incorrectness of this statement when discussing the picture and statement on page 2.

On page 4 of respondent's Appendix it is said: "Same structure as on two preceding pages." There is no evidence of this on the record. Similarly, there is no evidence that page 5 of the Appendix, saying, "showing same device as on three preceding pages," is true. So, also, page 6 of the Appendix, says: "Showing same device as on four pages just preceding." There is no evidence for this statement in the record.

It is attempted to give the impression on page 4 of the Appendix that the structure shown in the picture was used at the time of trial. The citations given by respondent as Liebel Record, pages 27, 28, 29, 61, 63 and 181, do not support this inference. ~~(There is no page 181 in the Liebel Record.)~~ The picture of page 4 simply shows the shifting idea of the Murray Patent No. 854,959, and as petitioner's present machines are capable of being used for shifting, some of the machines are marked with the Murray shifting patent.

The witness Cavanagh in the Liebel-Binney case

on page 61 testified that 70% of the trade use petitioner's present devices, and in answering this question had before him the actual devices, Exhibits 11, 12 and 13 (not to be confused with the catalogue pages of the same numbers).

On pages 7 and 8 of the Appendix are shown pictures of the Murray patent No. 854,959. But opposite to page 7 appears the misleading statement that seventy per cent. of all scaffolding devices licensed and used in the United States at the time of and prior to this suit were thus marked and used. "Seventy per cent. *of the trade* use the petitioner's actual devices," as we have just pointed out. But the statement opposite to page 7 asserts that the structures shown in the Murray patent are used. There is no proof to that effect in the case. The proof is diametrically opposite (Liebel Rec., p. 35):

"How do they differ? A. Previously, when we first issued our devices, they were *irremovably riveted together*.

"Q. They weren't riveted together in 1910?

A. No, sir."

It will be noted that the Murray patent No. 854,959 shows them riveted together, and so the above testimony shows that such devices were not riveted together in 1910. Thus the statement in the Appendix opposite page 7 is contrary to the record.

On the frontispiece of the Appendix it is said:

"Pages 2 to 6, inclusive, show cuts and catalogue pages (illustrative and descriptive) of scaffolding and scaffolding devices, sold, rented and used by plaintiff and its licensee companies continuously since 1907."

In view of what we have above shown, this statement is clearly misleading. Pages 2 and 3 are only counsel's pictures and the testimony of Henderson and La Belle does not come up to the requirements of convincing proof.

Equally misleading is the statement that the Liebel-Binney testimony shows that the structures of the five pages were identical with those used from prior to 1910 to the time of trial, when there is no proof of pages 2 and 3 in the Liebel Binney case, and when the Liebel Binney testimony is contrary to the inferences sought to be given by the statement.

The statement also asserts that "None were made or marked under the Henderson patent in suit, nor were structures made under that patent used to any extent commercially." But Henderson testified in the Chain Belt case that one thousand machines were made by him or the Henderson Scaffold Hoist Company in about two years (Chain Belt Rec., p. 135, Q77); and Pitou testified in the Liebel-Binney case that some 300 machines were in Atlanta, Ga., and were not marked with the Murray patent (Liebel Rec., p. 37). This testimony contradicts respondent's statement that *all* devices were marked and that no Henderson machines were used. And French testified in the Chain Belt case (p. 72, Qs. 2 to 9) that "practically every building that was hung with scaffolds was hung with that type of machine," meaning the Henderson.

That petitioner modified his *rigidly riveted* structures and discarded them as practically junk and made its structures hinged or loose jointed as first disclosed in the Henderson combination is abundantly proved. Davidson, a witness called by

respondent, testified that the earlier machines were *rigidly* bolted (Chain Belt, p. 160, Qs286, 287, 288), saying, "it had a piece across bolted at the bottom" and "two pieces come down" and the "putlog is bolted to those two frames." In 1910, his engineers got to work after knowing of Henderson's machines, and commenced in 1910 to put an improved machine out, in which they were successful (Chain Belt, p. 160, Qs289 and 294). And Pitou testified in the Liebel-Binney case (Liebel Rec., p. 35) that when his company first issued its devices, they were "*irremovably riveted together*," but a short time before the awarding of the medal in 1910, these were discontinued and no longer riveted. And Davidson on page 53, last question on the page, of Liebel Record, says as to page 11 of the catalogue Defendant's Exhibit C, that that structure is not used, and that to-day the structures are taken down, with the drums separate and the putlogs separate. On the first question of page 54 (Liebel Record) Davidson says the frames are *separate* from the putlogs. Davidson explains what he means by the designation Murray *type*—simply a platform type. When speaking of *structures*, he meant a structure like the Murray patent No. 854,959 (Liebel Rec., p. 52). Cavanagh in the Liebel-Binney case says that when he commenced work for the petitioner in August, 1910, the company was not using the machine shown in the circular Defendant's Exhibit C on pages 10, 11 and 13.

He says on page 63 of the Liebel record:

"Q. The type of machine that you have been speaking about is the one shown on this circular, Defendant's Exhibit 'C,' on pages 10, 11

and 13, is it not? A. Yes, it looks like the machine.

"Q. This is the kind that you have been installing during that time, is it? A. During what time?

"Since you have been with the New York Scaffolding Company? A. Yes, sir, since I have been with the company.

"Q. And that was since 1910—what time in 1910? A. I went with the company in August.

"Q. And they were using that device at that time? A. Not when I first went there."

How it is possible on all this testimony to assert as respondent does on page 1 of its Appendix, that pages 2 to 6 thereof, show pictures of machines used by plaintiff continuously since 1907 passes comprehension!

Opposite to page 18 in the Appendix is the statement that the structures of the Henderson patent were never used by the plaintiff. We have already shown that Pitou testified that 300 Henderson machines were in Atlanta, Ga., and the records amply prove the shipments of petitioner's machines in separate U-shaped frames and separate putlogs just like the Henderson patent, in distinction to the cumbersome one-piece *irremovable riveted* machine of the Murray patent. But even assuming that no use of the Henderson patent was made—under the Paper Bag patent case—this Court held that the patent is valid, nevertheless (Paper Bag Patent case, 210 U. S., 415, U. S.). *The point at issue here is not whether the plaintiff used the patented device, but whether the defendant used it.* That a patentee is entitled not only to what he specifically sees, but to what has been brought about by his invention, even though not

at that time actually seen, is clearly stated in *Kuhlman El. Co. v. General El. Co.*, 167 Fed., 709, at page 712 (C. C. A., 7th). And so Henderson first disclosed to the world his *combination*, and *inherent* therein is the hinge connection (not found in *Murray*). It is this that the record shows is present in the petitioner's devices whether the U frames are used edgewise or broadside. The result obtained is new and desirable, adding substantially to the efficiency of the operating service of scaffolding devices as stated in *Jones v. Evans*, 215 Fed., 586, C. C. A., 7th.

That the field of labor here in issue subjects workmen to great strain and tension as in the hoisting apparatus for coal towers (as in *Mead-Morrison Co. v. Exeter Works*, 225 Fed., 489, C. C. A., 3rd) is evident from respondent's picture on page 20 of the Appendix. This picture is injected into the case without proof of any kind, and was not before the Court of Appeals of the Third Circuit, as is inferable from the page opposite to page 18. It is pure fiction. There is not a word of proof in the case, that "jars on the platform would cause one of the windlasses to be forced off end of putlog," much less that a wheelbarrow would have the same effect. Henderson used his devices for two years without accident, as the record shows, and petitioner used the frames broadside (*Liebel Rec.*, p. 65) without accident. Henderson to prevent even the possibility of such slipping simply put a penny nail through the wooden putlog on the outside of the frames (*Chain Belt Rec.*, p. 157, Q346). This *combination* worked efficiently, and gave the desired flexibility throughout. This expedient of the nail is not shown in the patent in

suit. In this one is reminded of the Telephone Patent case, where that very successful invention was shown rather vaguely in the drawings, but the Court recognized the principle inherent therein even though not shown in the most perfect manner (Telephone cases, 126 U. S., 572).

The picture on page 20 of the Appendix proves, if it proves anything, the fact that the Henderson invention was not obvious. It is just such a thing that one would not do. The artisan would make the irremovably rigidly riveted Murray structure as shown in Patent No. 854,959. He might make the hoisting mechanism secure to the outriggers as shown on page 16 of the Appendix (Cavanagh patent), or provide rigid clips 8 on page 15 of the Appendix (Foster patent), or the rigidly bolted bars d¹ of Clark as shown on pages 12 and 13 of the Appendix—but no one made the connection loose or flexible before the advent of the patent in suit. It remained for Henderson, gifted with creative faculties, to invent a new mode of operation as exemplified in his *combination*. The problem was a "peculiar" one, as in *Jackson v. Peerless Co.* (C. C. A., 6th), 228 Fed., 691, and *Cadillac v. Austin*, 225 Fed. 983 (C. C. A. 6th).

III.

Response to pages 70 and 71 of respondent's brief, which assert that Whitney is free to contest over and over again that which has once been decided against him.

On page 70 of the respondent's brief, it is asserted, when speaking of Whitney's answer in the Liebel-Binney case:

"He appeared there, not for the purpose of litigating the issues between him and plaintiff, which were already the subject of a decree in the Eighth Circuit."

Notwithstanding this statement respondent Whitney did actually re-litigate the issues throughout this litigation.

The respondent, Liebel-Binney Construction Company, in its amended answer (Liebel Rec., p. 11, at p. 16), set up the decree of the District Court of Nebraska, Omaha Division, which dismissed the bill and declared the patent in suit invalid, and pleaded that the "Whitney Scaffold Hoist" machines were purchased by the Liebel-Binney Construction Company from Whitney's successor, and that "defendant * * * is *in privity with the said Egbert Whitney*, * * * and is entitled to the protection of said decree."

Thereafter respondent Whitney prayed "(1) that he may be made party defendant, and (2) that the answer of defendant now on file be treated as and for the answer of petitioner, and (3) that the petitioner may be permitted to defend this cause as a party defendant." (Liebel Rec., p. 73, last paragraph of page.)

But the order entered, ordered only that he be "made party defendant herein," as prayed for in his petition, and did not order that the answer of defendant on file be treated as and for the answer of petitioner. (Liebel Rec., p. 80, Par. 1.) Hence, Whitney took the order for less than prayed for. His prayer, asking that the Liebel-Binney Construction Company's answer be treated as his answer, *admits*, however, the correctness of the Liebel-Binney answer "that defendant is in privity with said Egbert Whitney." This admission was made in August, 1915 (Liebel Rec., p. 74), before the Omaha decree, after mandate was entered, which was entered on November 15, 1915. The amended answer and the prayer and order prove that respondent Whitney desired to avail himself of the decree of dismissal of the Eighth Circuit, which at that time was in his favor, but Whitney did not at the Pittsburgh trial attempt to prove the Omaha decree of dismissal. Equity Rule 37, under which Whitney was permitted to intervene reads in part as follows:

"Anyone claiming interest in the litigation may at any time be permitted to assert his right by intervention, but the intervention shall be in subordination to, and in recognition of the propriety of the main proceeding."

When the parties went to trial at Pittsburgh the Circuit Court of Appeals of the Eighth Circuit had already decided, in the suit brought against Egbert Whitney upon the Henderson patent in issue, that this patent was valid and had been infringed by Egbert Whitney, by making and selling the exact devices here in issue, to be used so as to construct the patented scaffolds.

However, as appears from the allegations of the proposed supplemental bill (Liebel Rec., p. 87), and from the petition for leave to file the supplemental bill (R., p. 85), at the time the parties went to final hearing, the mandate of the Circuit Court of Appeals had not yet been issued, and, as a result, no formal decree had as yet been rendered in plaintiff's favor.

However, before the Honorable District Court rendered its decision herein, such a decree was rendered in favor of the plaintiff against Egbert Whitney, and this was duly brought to the attention of the Honorable District Court by a petition praying leave to file a supplemental bill.

We thus submit that a clear case exists herein of new facts arising after the filing of the original bill of complaint, and which did not exist until after the final hearing herein.

Under these circumstances, we submit that judicial discretion should permit the filing of the proposed supplemental bill of complaint, so as to get a decree *in personam* against Egbert Whitney, and secure a uniformity of decisions throughout the country as far as Egbert Whitney is concerned (Rubber Tire Wheel Co. v. Milwaukee Co., 154 Fed., 358, 363, C. C. A., 7th). But we submit that, as a matter of comity, and to avoid the existence of conflicting decrees with respect to the same person, namely, Egbert Whitney, that the proposed supplemental bill should have been filed and proceedings had with respect thereto.

The final decree of Judge Orr in the Pittsburgh case dismissing the bill of complaint disposed of the motion to file the supplemental bill. The appeal from this final decree in equity to the Court

of Appeals of the Third Circuit brought up all matters including interlocutory proceedings before the lower Court (*Mendenhall v. Hall*, 134 U. S., 567) and the assignment of errors raised the error as to the disallowance of the supplemental bill when it stated (*Liebel Rec.*, p. 92) as one of the assignments of error:

"In denying the petition of the plaintiff herein for leave to file a supplemental bill setting forth the mandate and the decree after mandate in the case of *New York Scaffolding Co. v. Egbert Whitney* in the U. S. District Court of Nebraska, Omaha Division."

The Court of Appeals for the Third Circuit did not speak of the motion to file the supplemental bill of complaint, though it should have reviewed all the interlocutory proceedings of every character in the cause (*Loveland on Appellate Jurisdiction* on p. 133, Sec. 57), especially as a point was made in the petitioner's brief.

Had the Court of Appeals for the Third Circuit allowed the filing of the supplemental bill of complaint, the Omaha decree after mandate could have been proven into the cause and thereby both the *Liebel-Binney Construction* and *Whitney*, who admittedly were in privity with each other, would have been bound by the Omaha decree after mandate holding the patent in suit valid and infringed by the "Whitney Scaffold Hoist" Machine.

Respondent's brief on page 71 also says, in like tenor as in the statement about the *Liebel-Binney* case:

"Whitney did in that case join in the answer of the Chain Belt Company, but this

could only be for the purpose of meeting the issues asserted against that company, not for the purpose of re-litigating the questions determined, or under process of determination in the prior suit against him in the Eighth Circuit."

But the record shows that Whitney intervened (Chain Belt Rec., p. 28) as a defendant (not under Equity Rule 37) because the Chain Belt Company was the only manufacturer which was making these devices for Whitney, and that the devices claimed to infringe were being purchased exclusively by Whitney from the Chain Belt Company. Whitney having become party defendant, application was made by the plaintiff, and plaintiff was allowed to file a supplemental and additional bill of complaint (Chain Belt Rec., p. 49), alleging that a decree had been entered in the United States District Court of Nebraska, Omaha Division, on the 15th day of November, 1915, that Egbert Whitney had infringed the valid Letters Patent No. 959008 (Chain Belt Rec., p. 50). It was ordered that (Chain Belt Rec., p. 53) the plaintiff may file its supplemental bill, whereupon the answer to the supplemental bill was filed by the defendants on May 8, 1916 (Chain Belt Rec., p. 55), in which it is stated that Whitney agreed to defend and indemnify the Chain Belt Co. against loss which might be suffered because of infringement suits (Chain Belt Rec., p. 56), and in which it is denied that the Chain Belt Co. had ever had any connection with said Whitney save as hereinbefore pointed out, which refers to the admission in the answer that the Chain Belt Company manufactured the devices for Whitney.

There is this admission in this record (Chain Belt Rec., p. 57):

"Defendants admit that said Egbert Whitney *agreed to conduct the defense of this suit*, and that this was *consented to* by the Chain Belt Co."

From this clear admission it appears that whatever rights the Chain Belt Company might have had before this admission to independently defend this litigation, and seek to obtain an adjudication in their favor, contrary to that of the Eighth Circuit, they abandoned and surrendered it and consented that Whitney in effect be substituted for the Chain Belt Company. By this substitution, all decrees against Whitney became, under this consent of the Chain Belt Company, decrees binding upon the said Chain Belt Company.

With the Omaha decrees against Whitney as the substituted party defendant in the Chain Belt case, it follows that those decrees were binding on him "finally and everywhere" as to the matters there in issue, since those decrees were decrees *in personam* (*Kessler v. Eldred*, 206 U. S., 285 and *Diamond Co. v. Consolidated*, 220 U. S., 428).

In that it appears that the Chain Belt Company is the only manufacturer who made the device exclusively for Whitney by the admission of the said Whitney, and in that it appears from the admission of both defendants, the Chain Belt Company and Egbert Whitney, that Whitney was conducting the defense of the Chain Belt suit and that this was consented to by the Chain Belt Co., and in that it appears that the Liebel-Binney Construction Co. is actually in privity with Whitney, it follows, we submit, that both the Chain Belt Com-

pany and the Liebel-Binney Construction Company are bound by the Omaha decree against Whitney.

"An estoppel by decree exists, although the demand in the two cases is not the same, whenever the question upon which the recovery in the second case depends has been before decided, under like conditions, between the same parties or those in privity with them. *Southern Pacific R. Co. v. U. S.*, 168 U. S., 1; 18 Sup. Ct., 18; 42 L. Ed., 355,"

as said by Judge Lurton in *Penfield v. Potts*, 126 Fed., 475, at page 480 (C. C. A., 6th), citing *Lane v. Welds*, 39 C.C. A., 528; 66 Fed., 286.

In the case of *Kessler v. Eldred* (206 U. S., 285), Kessler only assumed the defense in the Breitwieser case and was compelled in the proper discharge of his duty to his customers to assume the burden and expense of all suits which may be brought against other customers, whereas in the cases at bar, the Chain Belt Co., and the Liebel-Binney Construction Co., were in privity with Whitney.

In *Kessler v. Eldred*, this Court said:

"It may be that the judgment in *Eldred v. Kessler*, will not afford Breitwieser a customer of Kessler, a defense to Eldred's suit against him. Upon that question we express no opinion. Neither it nor the case in which it is raised are before us" (See also, *Diamond Co. v. Consolidated*, 220 U. S., 428).

But in the cases at bar, in the Chain Belt case, the Chain Belt Company is the exclusive manufacturer of the identical machine of the Omaha case, and Whitney conducted the defense which was consented to by the Chain Belt Company.

The Liebel Binney Company is in privity with Whitney, as clearly appears by an admission, and we urge respectfully that both the Chain Belt Company and the Liebel-Binney Construction Company became bound as to the validity of the patent and as to its scope, as set forth in the broad concluding paragraph of 224 Fed., 452;

"Let the decree below be reversed and let a decree for an accounting and for an injunction against the manufacture, and sale by the defendant, Whitney, or his agents, of his hoisting device and hoisting frame for use or sale *in the combination of Claim 1 or of Claim 3 of Henderson's Patent, or for any other purpose* than use in a scaffold made by laying a plank or planks on the lower bars of two of his hoisting frames placed with their edges to the wall of the building, be granted."

We urge all of the above in response to the elaborate treatment in respondent's brief in criticism of the original Eighth Circuit of Appeals opinion of Judge Sanborn. The correctness of that opinion is not before this court, we respectfully submit, and the decree after mandate that followed that opinion estops Whitney and all those in privity with him from questioning that opinion or the decree founded thereon (*Penfield v. Potts*, 126 Fed., 475, at p. 480; *C. C. A.*, 6th; *Lane v. Welds*, 99 *C. C. A.*, 528; *Southern Pacific R. Co. v. U. S.*, 168 *U. S.*, 1).

We respectfully urge the above also against respondent's statement on page 71 of respondent's brief:

"Plainly,that case (referring to the Eighth Circuit case)did not preclude him [Whitney] from assisting his employes

or vendees in resisting attacks made upon them."

We respectfully submit on the authorities above cited, and in reason and logic, Whitney is estopped by the decree against him in the Eighth Circuit and with him are estopped his privies.

IV.

Reply to respondent's assertions as to the file wrapper and contents of patent in suit.

Respondent's brief repeats and reiterates the claims in suit were limited to a "single" bar. (See page 53 of Respondent's Brief.) But the *claims* were not limited thereto.

We will now take up the file-wrapper and contents of the Henderson patent in order to show therefrom that, when the history of that patent is duly and properly considered, there is nothing therein which limits the combination either of claim 1 or claim 3 of the Henderson patent to a structure in which the frame which at once carries the hoisting device and provides means for holding one end of each cross-beam, must necessarily, be made all in one piece; at least, the combination of claims 1 and 3 of the Henderson patent, being new, *qua* combination, it is no undue expansion of the doctrine of mechanical equivalents to contend and to hold that the frame of each hoisting device of the Whitney patents, is the mechanical equivalent both in construction and principle of operation, of one feature of the hoisting device of these claims, namely, "a con-

tinuous U-shaped metal bar" of claim 1 of the Henderson patent, or the U-Shaped bars of claim 3 of the Henderson patent. The word "continuous" in claim 1, or the word "U-shaped" in claim 3, cannot have placed upon it the narrow construction for which the respondents contend in order to avoid infringement. The respondents confuse "continuous" with "integral." In the combination shown in figure 1 of the Whitney's patent (Whitney's patent, Tr., p. 394), the scaffold there exhibited shows, for all practical purposes, the continuous U-shaped metal bar of claim 1 of the Henderson patent, as well as the plurality of U-shaped bars of claim 3 of the Henderson patent, performing the same function and "*united under the same co-operative law*" (see *Leeds & Catlin Co. v. Victor Co.*, 213 U. S., 318) as found claimed, in combination, in claims 1 and 3 of the Henderson patent in suit.

Similarly, Whitney's second patent (Tr., p. 402) shows the U-shaped frame operating in the same manner as the frame of the patent in suit, with the other parts of the combination. The mere subterfuge of running the cables *loosely* through holes in the putlogs does not avoid the claims, as enough of the invention is appropriated and besides, if the machines alone are supplied, the contractors will rig them as testified by Kimball (Ch. B., Rec., p. 107), and as shown by Henderson.

Now, taking up the file wrapper and contents of the Henderson patent in the light of the decisions in analogous cases, to which we shall presently refer, there is nothing in the history of that application which would permit the respondents to escape infringement merely because the horizontal lower portion of the frames which carry

the hoisting devices, which horizontal lower portions are intended to carry the cross-beams, are not actually made integral with said frames.

Respondents seek to give the impression that the claims were limited during the prosecution thereof in the Patent Office, as to not cover their structure. But, *claim 3 was allowed as presented*. The only change in claim 1 was the word, "continuous," and respondents have this feature. The claims do not limit the petitioner to an integral, one-piece U-shaped bar, but merely to a *continuous* U-shaped bar. "Continuous," according to the dictionaries, simply means without a break of interruption. Thus a railroad has *continuous* tracks, but not *integral* tracks, as they are made of individual rails. An aqueduct is composed of continuous piping, but not integral piping.

The law applicable to the consideration of the file wrapper and contents of an application for patent is thus tersely and clearly stated by the Supreme Court in *Hubbel v. United States*, at page 80 of 179 U. S.:

"It is quite true that, where the differences between the claim as made and as allowed consist of mere changes of expression, having substantially the same meaning, such changes, made to meet the views of the examiners, ought not to be permitted to defeat a meritorious claimant. While not allowed to revive a rejected claim, by a broad construction of the claim allowed, *yet the patentee is entitled to a fair construction of the terms of his claim as actually granted*.

As stated in *Horton v. White Lilly Mfg. Co.*, 213 Fed., 471 (C. C. A., 7th), "the rule is well elaborated," in the *National Hollow Brake-Beam Case*, at page 714 of 106 Fed.

On the above statement of the law as laid down by these leading cases we must—we are entirely willing to—stand; for we are not asking this tribunal to construe either claim 1 or claim 3 of the Henderson patent so as to include within its scope what was rejected by the Patent Office or disclosed by any prior patent. We are merely asking for a fair construction of claims 1 and 3 of the Henderson patent so as to cover the respondents' structures as designed and intended to be used and as exhibited by Figure 1 of the Whitney patent (Tr., p. 394). The scaffold and combination of devices there exhibited is essentially and substantially the identical structure claimed by claims 1 and 3 of petitioner's patent and exhibits a combination of co-ordinated, co-acting elements which, as combined and co-ordinated, are not found in any reference cited by the Patent Office to Henderson's application, and are not found in any structure or patent of the prior art.

In the light of the foregoing decisions let us see whether the Patent Office history of the Henderson patent can be fairly construed to prevent the patentee from contending that in the respondent's scaffold, as the respondent Whitney uses it in practice (see Whitney patent, Tr., p. 394 and Kimball Tr., p. 107), escapes infringement of either claim 1 or 3 of the Henderson patent, merely because one element of the Whitney scaffold as illustrated in Figure 1 of the Whitney patent—the frame which carries a hoisting device and supports one end of the cross-beam—has the bar of the frame which supports one end of the cross-beam made so that it *"is fitted at its end in the loops 17"* of the vertical sides of the frame instead of being made in one piece with the frame.

In the embodiment illustrated in the Henderson patent the horizontal lower portion of the U-shaped bar is made integral with the vertical members of the same U-shaped bar, this being the preferred, simplest and "best" construction, and therefore the preferable construction illustrated in the Henderson patent, in accord with Section 4888, R. S. U. S.

The file-wrapper and contents of the Henderson patent are found between Record, pages 185 and 199 of the Chain Belt case.

As originally presented, claim 1 (Tr., p. 189) did not contain the word "continuous," nor the words "the under side of" nor the word "hoisting," all of which words were afterwards inserted by subsequent amendments. But none of these words was required to be inserted by the Examiner. The Examiner never found any objection to claim 3 as found in the Henderson patent as granted. This claim 3 was inserted by applicant's amendment of November 16, 1909 (Tr., p. 193). As then inserted it was numbered claim 9, but afterwards the numeral was changed to 3. This claim 3 was never changed except to correct a typographical error therein by changing the word "lain" to "lay" (Tr., p. 195).

As to Claim 1 of the patent as issued, the Examiner never *specifically* objected to that claim in its original form. All that the Examiner did by his first letter of rejection (Tr., p. 192) was to cite to the application and claims generally the Murray, Howe, Bowyer *et al.*, Sladek, Harpin *et al.* and Crandall patents (see Tr., p. 192), and to say in connection with the citing of those patents: "None of the claims are seen to present invention over Murray. To arrange his U-shaped

frame with the closed end down, so as to extend around the cross-bar, would be obvious if desired." The rest of the brief letter of the Examiner dated August 31, 1909, and found at page 192, was a criticism of original claims 3, 6 and 10, relating to the positioning of a pawl so as to be operated by one's foot; but as those claims, relating to the pawl, etc., were abandoned and as no such claim is in issue, that part of the Examiner's letter throws no light on the present inquiry.

The Murray patent, which is the only prior patent which the Examiner laid stress upon in his letter last referred to, which Murray patent does not disclose the invention of claims 1 and 3 of the Henderson patent as allowed, as the Examiner conceded by finally allowing those claims, in a broad sense, did show the angle-iron frames of hoisting devices in *inverted* U-shape (see Murray patent, Tr., p. 384); but those *inverted* angle-iron U-shaped frames of the hoisting devices of the Murray patent were not provided with any lower bearing, either integral with or made "continuous" with the vertical members of the frame. Therefore, it was impossible, in the structure of the Murray patent, for any lower member to carry the end of a cross-beam, much less to pass under the cross-beam. On the contrary, in the Murray scaffold, the lower ends of the *inverted* U-shaped hoisting frames were *riveted* and *securely fastened* to horizontal cross-beams "c" (see Figure 2 of the Murray patent).

Furthermore, the scaffold of the Murray patent was so constructed that its *inverted* U-shaped hoisting frames were made *permanent* parts of the scaffold frame, upon which scaffold frame

the scaffold boards were to be set (see Figure 2, Murray patent). Therefore, the structure contemplated by the Murray patent was a *permanent and cumbersome frame* consisting of two hoisting devices permanently affixed to cross-bars "e" and was in no sense the *flexible* knock-down structure, capable of ready disintegration, or ready reconstruction of small units, and in no sense a pivoted or loose-jointed combination with the hoisting devices independently operable, such as shown and claimed in the Henderson patent.

For these reasons, to distinguish the Henderson knock-down scaffold from the device of the Murray patent and with reference to Claim 1 of the Henderson patent (we are not here concerned with what applicant's attorney said in trying to get other claims allowed, which claims are not in issue here), in his letters of November 11, 1909, and of March 8, 1910 (Tr., pp. 193 and 105), Henderson's attorney distinguished the actual U-shaped frame of the Henderson scaffold from the *inverted* U-shaped frame of the Murray patent. In the actual U-shaped frames of the Henderson patent those frames, in addition to holding a hoisting device in each frame, were also made in actual U-shape, like a stirrup, so as to hold in the base of the U or stirrup the end of a cross-beam. No such structure was presented in the Murray patent.

It was for the purpose of differentiating the Henderson structure from what was disclosed by the Murray patent that the words "the underside of" were inserted in Claim 1 by the amendment of November 11, 1909 (Tr., p. 193), and the word "continuous" inserted in that claim by the amendment of March 8, 1910 (Tr., p. 195).

Therefore, it is obvious, from this simple history of Claim 1 of the Henderson patent, that the amendments made in Claim 1 were not to limit that claim to a U or stirrup-shaped frame or bar *necessarily* having the supporting member of the stirrup integral with the vertical bars of the stirrup, but those amendments were inserted in Claim 1 merely to distinguish the *combination* of the Henderson knock-down scaffold with its actual U-shaped bar or frame from the *permanent* scaffold of the Murray patent with its *inverted* U-shaped frames, the lower vertical ends of which were *permanently* fastened to the cross-beam (see Murray patent). All this is also clear from the argument of Henderson's attorney before the Examiner after he had first amended Claim 1, in which argument Henderson's attorney said, among other things, as follows (Tr., p. 134):

"Claim 1 specifies that the U-shaped metal bar *extends around the under side of the beam*, while the ends thereof extend upwardly. Thus the connection between the U-shaped bar and the cross-beam is absolute and positive, *and no connecting rivets, bolts or other auxiliary means are employed.*"

This is further confirmed by a thoughtful and intelligent reading of the argument of Henderson's attorney in the amendment of March 8, 1910 (T. p. 195), in which he says in answer to the Examiner's second reference to the Murray patent, among other things, that the windlass or hoisting frame of the Henderson device "directly supports the scaffold members and this without resorting to a complicated frame or built-up structure, but by the use of a frame consisting of a single bar or

metal bent so as to support one end of a scaffold member *without the need of securing such member thereto.*"

It is true that in this statement, having the Murray device in mind, the applicant's attorney referred to the windlass frame being a single metal bar; but he shows what he means by that by the further statement that it is not made a permanent part of the scaffold frame as is the case in the Murray device. What the applicant was after in his *combination* was a stirrup, or actually U-shaped frame, in the U of which one end of a cross-beam could rest. Certainly, the simplest way to do this would be to make that frame of a single piece, in the form of a U-shaped bar; but the function and purpose of that frame and that element of his combination could be accomplished just as well by resorting to the unnecessary expedient of making the bottom of the U or the foot of the stirrup of a bar fitted into the ends of loops in the vertical arms of the stirrup, as is done in the first Whitney patent (Tr., 394), or by vertical rods having nuts on which a strap rests, as is done in the second Whitney patent or Little Wonder machine (Tr., p. 402). In either case the same function is performed by the bottom of the stirrup. Both the Henderson patent and respondent's structures are distinguished from the structure of the Murray patent, since the foot of the U or the foot of the stirrup in either case serves to support the end of a cross-beam directly and without the need of fastening the scaffold to the frame by bolts, rivets, etc., as is the case with the structure of the Murray patent. This was the difference that Henderson's attorney sought to point

out in his argument of March 8, 1910, it being then a question of distinguishing his structure from that of the prior Murray patent.

Before that argument was made the Examiner (Tr., p. 194), by letter dated December 14, 1909, had said:

"The claims are seen to present mere colorable and mechanical variations over Murray as previously applied. At best they present no invention over Murray in view of Bowyer *et al.*, showing a frame closed at the bottom."

But this objection was a general one made to nine claims which were then pending, many of which related to other features. The applicant abandoned six of those claims, which related to details of construction of the windlass, etc., but insisted upon Claim 1, merely adding thereto the word "continuous" as above stated, and also insisted upon present Claim 3 (then Claim 9), merely correcting the typographical error as hereinbefore pointed out, *with the result that the patent was allowed in its present form and all objections to Claims 1 and 3 were overcome*. From a study of the history of this application it is obvious that the Examiner found no obstacle to Claims 1 and 3 of the patent as issued by reason of the Bowyer *et al.* patent referred to in the Examiner's letter of December 14, 1909. The painter's stage of the Bowyer patent is clearly not the scaffold of either the Henderson patent or the Whitney patents. The Bowyer patent (Tr., p. 332) clearly showed that a stirrup-shaped frame in one piece was old, and, therefore, as Henderson did not claim that feature *alone*, the painter's stage of the Bowyer *et al.* patent was no obstacle to the grant of the Henderson patent.

Moreover, as we have already pointed out in defining the Henderson invention in the first part of this brief, the Bowyer *et al.* painter's stage utterly fails to disclose the invention of either claim 1 or claim 3 of the Henderson patent, and for the same reasons it does not disclose defendant's scaffold illustrated at Figure 1 of the Whitney patent (Tr., p. 394). Whitney's patents (Tr. pp. 394 and 402) show at least four hoisting frames, each frame containing a hoisting device directly supported in the side members of the frame, each frame adapted to hold in the stirrup thereof the end of a cross-beam, said frames being placed so that their broad sides shall be parallel with the face of the building, the structure thus being adapted to support, on the cross-beams running at right angles to the face of the building, a scaffold proper on which there shall be ample space with a minimum of obstruction to men and material on the scaffold. In the painter's stage of the Bowyer *et al.* patent, the built-up frame, made of a number of pieces which carry the windlass or hoisting drum, is arranged so as to be hung at right angles to the face of the building, and to carry in the stirrup or lower portion of these frames a single board. It is only necessary to read claims 1 and 3 of the Henderson patent in connection with the painter's stage of the Bowyer patent to at once see that the combination, co-ordination and arrangement of elements found in the Henderson patent and covered by claims 1 and 3 thereof is not present in the painter's stage of the Bowyer *et al.* patent; it is equally clear that the combination, arrangement and co-ordination of parts found in the scaffold of Whit-

ney's patents (Tr., pp. 394 and 402) is not the structure described, illustrated and claimed in the Bowyer patent (see, also, retaining spurs *f* and retaining arms *W* of Bowyer patent, Tr., pp. 332, 333).

We respectfully submit that it clearly follows from what we have said and from a careful examination of the file wrapper and contents of the Henderson patent that claims 1 and 3 of the Henderson patent were not allowed upon the theory that those claims could not be interpreted to cover a structure like respondent's scaffold illustrated by Figure 2 of the Whitney patent in which the lower bar of each frame is made in a separate piece "fitted at its ends in loops" in the vertical bars or sides of the frame or the stirrup of the second Whitney patent; on the contrary, a careful examination of the file wrapper and contents of the Henderson patent will show:

(a) That claim 3 as found in the patent was never modified or changed in any respect except to correct a typographical error therein.

(b) That the insertion of the words "continuous" etc., by the amendments of November 16, 1909, and March 8, 1910, and the arguments accompanying those amendments were not by any means intended to limit those claims to a structure in which the lower portion of the U-shaped frame should *necessarily* be made integral with the vertical members, but that those amendments or changes in claim 1 were merely for the purpose of differentiating the Henderson *combination*,—"continuous" being a generic word to include the specie "integral" or any other specie

functioning to carry out the cooperative law of the combination.

Judge Noyes in *Westinghouse v. Condit*, 194 Fed., 427, at 430 says:

"But, as a general rule, the interpretation to be placed upon the claims and specifications of a patent, is to be determined from the language of the grant, and the proceedings in the Patent Office are quite immaterial. Such is the situation in the present case. Original claims were rejected in the Patent Office. Thereupon, the applicants, instead of limiting their claims, substituted broader ones which were accepted. *Presumably the Examiner changed his mind.* But whatever be the explanation of his position, nothing whatever is shown to work an estoppel against the patentees. *Instead of surrendering something which they now claim to obtain that which was allowed, they claimed something more and got it.*"

And as to Whitney's alleged benefits or disadvantages, it is clear infringement is not avoided by impairment in degree so long as the distinguishing function is retained. *Murray v. Detroit Co.*, 206 Fed., 465, 468 (C. C. A., 6th).

Respectfully submitted,

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